
IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT, *7*

No. 6996

OTIS ELEVATOR COMPANY,
Plaintiff, Appellant and Cross-Appellee,

vs.

PACIFIC FINANCE CORPORATION AND LLEWELLYN
IRON WORKS,
Defendants, Appellees and Cross-Appellants.

PETITION FOR REHEARING OR FOR MODIFICATION OF THE
OPINION OF THIS COURT FILED HEREIN
JANUARY 23, 1934.

WALLACE R. LANE,
WILLIAM H. HUNT,
EDWIN W. SIMS,
CLARENCE J. LOFTUS,
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PETITION FOR REHEARING OR FOR MODIFICATION OF THE
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JANUARY 23, 1934.

The Otis Elevator Company, plaintiff, appellant and cross-appellee, (herein referred to as plaintiff) respectfully submits that it has been aggrieved by an opinion of your Honors filed herein January 23, 1934 in the respects hereinafter set forth and hereby petitions this Honorable Court for a rehearing of said matter.

The opinion of this Court, filed January 23, 1934, on which this petition is predicated, concluded with the statement—

“On the cross appeal the decree will be reversed with directions to dismiss the bill; plaintiff’s appeal thereby becomes moot and as such will be dismissed.”

This direction to dismiss the bill and make moot plaintiff's appeal is predicated solely on the erroneous finding that claim 37 of the Parker patent is "*invalid because it claims only the function or result of an invention,*" and that plaintiff after notice thereof failed to file a seasonable disclaimer.

This Court originated the finding and was the first to hold that claim 37 of the Parker patent is "*invalid because it claimed only the function or result of an invention.*"

This novel theory of invalidity has taken plaintiff entirely by surprise as it was not briefed or argued on either side before this Court, or included in the assignment of errors (R. 658). Never have defendants contended or even suggested that the Master or the trial Court held that claim 37 was invalid *because functional only*. This is the first opportunity we have had to be heard on this question.

The opinion of this Court, in view of the holding simultaneously and for the first time that claim 37 was "*invalid because it claims only the function or result of an invention,*" and that a disclaimer thereof should have been filed prior to such holding, also presents the question:

Was a disclaimer necessary before the opinion of this Court becomes final?

A fundamental mistake in the opinion, as we see it, is based on the statement (p. 9) :

"Even a casual reading of the claim and the Master's finding discloses that the invalidity was not merely because of indefiniteness but *because it covered only a function.*"

We think that a *careful* analysis of claim 37 and the decisions of the Supreme and other federal courts set forth in the accompanying brief will conclusively demonstrate that this claim is for a proper "sub-combination" and is not "*for a function only.*"

Furthermore, this is the first time that any tribunal has held or indicated that there was such delay in filing a disclaimer as to render an entire patent invalid, where a Master had recommended that a claim of an otherwise valid patent be held invalid because indefinite as not complying with Section 4888 of the Revised Statutes, where the court which appointed the Master had not passed upon his report or entered any decree pursuant thereto, and where the owner of the patent had voluntarily filed a disclaimer during the pendency of the cause before the trial Court.

We hope that the Court will appreciate our analyzing the claim in question, applying the decisions of the courts to it, and pointing out inconsistencies between the opinion of this Court and accepted principles of law, as we have done in our attached brief, especially as the final opinion of this Court on the questions involved are of vital importance to the proper administration of justice and to the property rights of inventors generally in this country.

WE RESPECTFULLY SUBMIT:—

1. That claim 37 of the Parker patent in suit is *not* “invalid because it claims *only the function or result of an invention*”;

2. That plaintiff had no reason to anticipate this novel, and what we believe to be erroneous, finding of this Court and filed a disclaimer years before the finding was made. (The Patent Office in allowing claim 37 held it not functional, and until the decision of this Court no other tribunal has held that it was.)

3. That the statement by this Court, on which its opinion is largely predicated, that—

“Even a casual reading of the claim and the Master’s finding discloses that the invalidity was not

merely because of indefiniteness but because it covered only a function,"

fails to take into consideration the numerous decisions of the Supreme and other courts, which conclusively show that claim 37 was for a *proper sub-combination* of mechanical elements* and does not "cover only a function."

An examination of the claims held valid in *O'Reilly v. Morse*, 15 How. 62, cited by the Court (as distinguished from claim 8 held invalid) and the claims before the court in the Bell Telephone case, (which distinguished between such a claim as claim 8 of the Morse patent, its other claims, and those of Bell and Parker's claim 37), and other decisions of the Supreme and other federal courts, shows that claim 37 was a proper claim, and one of the type commonly used for electrical devices and repeatedly sustained by these courts.

4. That the statement of this Court also fails to appreciate that the Master's recommendation was predicated on his conclusion that "the circuit and circuit closing means" are not included in the claim, whether functionally or otherwise, and for that reason only did he conclude that this claim does not comply with Section 4888 of the Revised Statutes.

5. That had plaintiff not voluntarily filed a "proper" though "unnecessary" disclaimer, because of the Master's holding of indefiniteness of claim 37 and because the other claims adequately protect the invention, two years and nine months before the opinion of this Court of January 23,

* *Thomson-Houston Electric Co. v. Black River Traction Co.*, 135 Fed. 759, 763, C. C. A. 2.

Wright v. Herring-Curtiss, 204 Fed. 597, and affirmed on opinion below, C. C. A. 2, 211 Fed. 654, 655.

Deering v. Winona Harvester Works, 155 U. S. 286, 302.

Roberts v. H. P. Nail Co., 53 Fed. 916, Circuit Judge, later Chief Justice Taft.

Taylor v. Sawyer Spindle Co., 75 Fed. 301, C. C. A. 3.

Chambers-Bering-Quinlan v. Faries, 64 Fed. 587.

Hancock Inspirator Co. v. Jenks, 21 Fed. 911, Judge, later Justice, Brown.

1934, no disclaimer would have been necessary until after a final decision of this Court holding this claim "invalid because it claims only the function," and until after plaintiff had exhausted all of its rights of a review of such decision, or until the time had run for seeking such review;

6. That plaintiff was under no duty to except to the Master's recommendation that claim 37 be held invalid because indefinite, or to file a disclaimer thereof before May 1, 1931, or indeed, unless and until this Court shall have finally concluded that claim 37 is invalid because it claims only a function.

7. That had plaintiff at the time it elected to file a voluntary disclaimer seen fit to have called the trial Court's attention to the finding of the Master with respect to the validity of claim 37, it could have done so, and the trial Court could have passed upon the propriety of the Master's recommendation, but having elected to file the disclaimer long before the Court had occasion to pass upon this question, the disclaimer was filed before plaintiff exhausted its rights of review.

8. That the trial Court was right in holding that (R. 633)

"where no final decree is made adjudging any claim of a patent to be invalid, the patentee is not required to disclaim,"

and as—

"There was no decree interlocutory asked for to confirm the report as to the finding of invalidity for lack of exception taken, hence in my view the matter remained at large and the commencement of the reasonable time within which the plaintiff might disclaim would be the entry of such decree."

9. That the trial Court properly denied defendants' motion to dismiss the bill of complaint predicated on the statement that the Master found claim 37 of the Letters Patent

in suit invalid under Section 4888 of the Revised Statutes, as distinguished from any allegation that said claim 37 was invalid as covering a function only, or because it claimed more than that of which the patentee was the original or first inventor or discoverer.

10. That neither the disclaimer statutes nor the decisions of the courts with respect thereto contemplate the necessity of filing any disclaimer until the patentee has discovered or become *aware with certainty* that he has claimed more than that of which he was the original or first inventor or discoverer.

Neither the disclaimer statutes nor the decisions contemplated that the patentee file a disclaimer in a situation like the present one, *where so many uncertainties* exist and where *there is so much controversy* concerning—

(a) Whether disclaimer was “proper or necessary.”

(b) Whether the Master’s report that claim 37 was invalid only because it did not comply with Section 4888 of the Revised Statutes.

(c) Whether before the Master’s report was confirmed plaintiff had lost its right to have the trial Court review the Master’s report by failure to except thereto.

(d) Whether the claim was invalid simply for *indefiniteness*, or because it covered *only* a function, and where in the former case a disclaimer would not be required, while in the latter case one would be.

(e) Whether a disclaimer must be filed before a patentee has discovered or become *aware with certainty* that he has claimed more than that of which he was the original or first inventor or discoverer.

11. That in the face of such uncertainty as has been exhibited in this case a court of equity should not retroactively impose on a patentee the duty to disclaim a claim which it for the first time simultaneously determines to be invalid as functional only.

12. That a reversal of the decree of the District Court

on cross appeal with directions to dismiss the bill, and the dismissal of plaintiff's appeal as moot, is erroneous.

In support of such statements of fact as do not appear in the printed record we tender an affidavit of Wallace R. Lane, of counsel for plaintiff, with exhibits appended thereto, as follows:

Exhibit A—Plaintiff's contentions with respect to claim 37 and the authorities filed before Master January 13, 1930.

Exhibit B—Plaintiff's brief on defendants' motion to dismiss the bill of complaint in the trial court.

Exhibit C—Defendants' exceptions to Master's report involving claim 37.

Wherefore, and for the reasons stated in the accompanying brief, it is respectfully submitted that a rehearing be granted, or in the alternative, the opinion of this Court should be reversed or reformed as to hold:

(a) That the said claim 37 is a valid claim for a sub-combination of elements of a control system for an elevator car described in the specifications of the Parker Reissue patent No. 16,297;

(b) That the Master erroneously held such claim invalid;

(c) That no question as to the time of filing a necessary disclaimer of claim 37 arises until a reasonable time after the granting or denial of this petition, and the running of the time allowed for filing a petition for certiorari to the Supreme Court of United States, and if such petition is filed, only after that court shall have either denied it or passed upon the question of whether claim 37 covered only a function;

(d) That the disclaimer filed by plaintiff on May 1, 1931, in view of the finding of the Master that the claim was not sufficiently definite to comply with Section 4888 of the Revised Statutes, was proper though unnecessary;

(e) That plaintiff did not unreasonably delay the filing of a disclaimer of such claim;

(f) That the District Court properly denied defendants' motion to dismiss the bill of complaint;

(g) That defendants' cross appeal be dismissed; and

(h) That plaintiff's appeal be allowed on the merits in all respects.

It is also respectfully submitted that the mandate of this Court may be stayed pending the disposition of this petition.

Respectfully submitted,

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*Counsel for Petitioner, Otis
Elevator Company.*

I, Wallace R. Lane, of Chicago, Illinois, an attorney regularly admitted to practice in the United States Circuit Court of Appeals for the Ninth Circuit, do hereby certify that in my opinion the foregoing petition for rehearing in the case of Otis Elevator Company, plaintiff, appellant and cross-appellee, versus Pacific Finance Corporation and Llewellyn Iron Works, defendants, appellees and cross-appellants, is well founded and is not presented for the purpose of creating a delay.

February 14, 1934.

WALLACE R. LANE.

I, William H. Hunt, of San Francisco, California, an attorney regularly admitted to practice in the United States Circuit Court of Appeals for the Ninth Circuit, do hereby certify that in my opinion the foregoing petition for rehearing in the case of Otis Elevator Company, plaintiff, appellant and cross-appellee, versus Pacific Finance Corporation and Llewellyn Iron Works, defendants, appellees and cross-appellants, is well founded and is not presented for the purpose of creating a delay.

February 21, 1934.

WILLIAM H. HUNT.

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BRIEF IN SUPPORT OF PETITION FOR REHEARING OR FOR MODIFICATION OF OPINION.

The direction in the Court's opinion to dismiss the bill with one stroke, and without consideration of the merits of plaintiff's appeal, will destroy the Parker patent for a highly meritorious invention, and, if the opinion is adhered to, vitally affect the rights of inventors throughout the country.

By its petition for rehearing filed herewith, the Otis Elevator Company, plaintiff, seeks a reconsideration of and rehearing on the opinion of this Court, which for the first time holds:

- (1) That claim 37 of the Parker patent in suit is "invalid because it claims only the function or result of an invention"; and
- (2) That plaintiff unreasonably delayed filing a disclaimer thereof, thereby rendering that patent invalid.

Plaintiff submits that this finding and conclusion is predicated upon and involves the following misapprehensions:

1. As to the nature and character of the Parker invention.
2. That claim 37 is "invalid because it claims *only the function or result* of an invention," whereas under the decisions of the Supreme and other federal courts with respect to such claims, this claim is for a proper sub-combination of mechanical elements necessary for the operation of a highly meritorious invention, clearly disclosed and described in the patent.
3. That a *reading of the Master's finding alone* as to claim 37 (that it "does not comply with Section 4888 of the Revised Statutes and is, therefore, invalid") "should have" made it "sufficiently apparent to plaintiff" that the Master had concluded that the claim was invalid because "it covered only a function," and for this reason plaintiff should have disclaimed promptly after the filing of the Master's report.
4. What was argued before the Master with respect to claim 37 when he submitted his draft report for suggestions and exceptions, and that plaintiff in resistance to defendants' motion to dismiss (which motion was based solely on the ground that the Master found claim 37 of the Letters Patent in suit invalid under Section 4888, and that plaintiff should have disclaimed promptly thereafter, R. 622) was that claim 37 was sufficiently definite as a sub-combination to comply with Section 4888 of the Revised Statutes under the authorities applicable, and that the disclaimer filed was "not necessary" though "proper".
5. That defendants ever contended or even suggested that the Master was of the opinion that claim 37 was invalid as for only a function, whereas defendants in filing

their exceptions to the Master's report insisted that he erred in failing to find that claim 37 of the Parker reissue patent in suit was invalid because—

- (a) anticipated by the patent to Strohm (Exception 61);
- (b) for an aggregation (Exception 76);
- (c) for a different invention than claimed in the original Letters Patent (Exception 111);
- (d) of intervening rights by the defendants (Exception 115);
- (e) of unreasonable delay in filing the application for reissue (Exception 122);
- (f) this and other claims of the patent in suit covered merely the function or abstract effect of a machine (Exceptions 30, 31, 32, 33);

Defendants thereby indicated and recognized clearly that the Master's finding as to claim 37 was simply that it was not sufficiently definite to comply with Section 4888 of the Revised Statutes, and not that it was invalid because it covered merely the function or abstract effect of a machine, or because it was void for any other reason than because not sufficiently definite. Contrary to the Court's opinion, these exceptions were obviously not conditional and precautionary only.

6. A misinterpretation of the disclaimer statutes and the decisions of the Supreme and other federal courts pertinent thereto, and a misapplication of them to the facts of this case in holding that a patentee is required to disclaim before he becomes *aware with certainty* that he has claimed "more than that of which he was the first or original inventor or discoverer." The opinion substitutes a *rule of doubt* as to invalidity of a claim because it claims "more than that of which the patentee was the first and original inventor or discoverer," *in lieu of conviction* with respect thereto.

**THE NATURE AND CHARACTER OF THE PARKER
INVENTION.**

CLAIM 37 IS FOR A PROPER SUB-COMBINATION OF MECHANICAL ELEMENTS NECESSARY FOR THE OPERATION OF A HIGHLY MERITORIOUS INVENTION, CLEARLY DISCLOSED AND DESCRIBED IN THE PATENT.

“The invention of Parker is an important one. Coming from one not trained in the art, it has taught the art a new means of control that solves many old problems. * * * the invention, judged by the results, is a radical step forward.” (Master’s Report, R. 574)

The Parker patent refers to his Control for Electric Elevators as—

“a novel system and means of control whereby the elevator car may be caused to automatically stop in proper alignment with predetermined floor levels by virtue of the actuation or setting of secondary control means, which may be provided within the car alone, or both within the car and at each floor level; said secondary control means being adapted to cooperate with the master control switch within the car, which master switch is subject to the manual control of the car operator.” (Patent, p. 1, lines 19-30)

Parker having illustrated and described his complete control system and means by which it was operated, and by claims 3, 22, 29, 40, 41 and 65 covered and protected this, secured the allowance of claim 37 covering a novel sub-combination and arrangement of mechanical elements designed to be used in connection with his control system, whereby the elevator could be operated to accomplish his desired result, well expressed in the Master’s report by the statement (R. 561)—

“Nothing in the prior art shows a combination of control means by which an elevator can be started by an operator and thereafter be stopped automatically at several landings in response to control means in the car and at successive landings in response to control means actuated at any time before the car reaches the selected landing.”

In sustaining claims 3, 22, 29, 40, 41 and 65 the Master held that these claims when read with the specifications amply protected this combination.

The Master, however, concluded that claim 37 did not include "the circuits and circuit closing means", shown in the patent, in any way, even in general terms, such as the means and mechanisms found in the other claims, and therefore concluded that this claim was invalid because it "does not comply with Section 4888 of the Revised Statutes."

Instead of this Court concluding, as the Master did, that claim 37 was invalid because it did not comply with Section 4888 of the Revised Statutes, its opinion holds that—

(a) "Even a casual reading of the claim and the Master's finding discloses that the invalidity was not merely because of indefiniteness *but because it covered only a function,*"

and cites: in support of this statement:—

Wyeth v. Stone, Fed. Cas. 18,107 (C. C. Mass.)
(1840).

O'Reilly v. Morse, 15 How. 62 (1854).

Holland Fur. Co. v. Perkins Glue Co., 277 U. S. 245, 247.

(b) "It is enough for present purposes to apply the principle that a claim, invalid because *it claims only the function or result* of an invention, unless properly disclaimed, invalidates the entire patent."

(c) "The purpose of the Master's finding as to claim 37 should have been sufficiently apparent to plaintiff upon a reading of that finding alone."

(d) "It fell because it specified substantially *nothing but a function.*"

(e) Any doubts as to the purposes of the Master's finding should have been dispelled by the Master's ruling with respect to claim 29.

Let us first consider whether claim 37 "is invalid because it covered only a function"; whether "it fell be-

cause it specified substantially nothing but a function"; and whether "the master's finding as to claim 37 should have been sufficiently apparent to plaintiff upon a reading of that finding alone" to have required the filing of a "necessary" disclaimer promptly after the filing of the Master's report.

CLAIM 37 IS FOR A PROPER SUB-COMBINATION.

Claim 37 is for a proper sub-combination which need not include a complete operative mechanism.* It should be construed with what Parker sought to and did accomplish by the mechanisms of his patent and not as mere abstract language. It has a sub-combination of a number of mechanical elements with their functions stated, and when combined with the mechanism which the up, down and starting switches, shown in the Parker patent, initiate and control, provides a control for an electric elevator in which an attendant is stationed within the car, the starting of the car being entirely under the control of an attendant in the car, and that once started, the car will continue to run after the car switch handle is moved to "off" position, whereas the stopping of the car in either direction of its travel at any landing is achieved by automatically pushing buttons either in the car or at the landings.

Claim 37 calls for the following positively included elements in a—

* *Thomson-Houston Electric Co. v. Black River Traction Co.*, 135 Fed. 759, 763, C. C. A. 2.

Wright v. Herring-Curtiss, 204 Fed. 597, affirmed C. C. A. 2, 211 Fed. 654, 655.

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Hancock Inspirator Co. v. Jenks, 21 Fed. 911, Judge, later Justice, Brown.

Taylor v. Sawyer Spindle Co., 75 Fed. 301, C. C. A. 3.

Roberts v. H. P. Nail Co., 53 Fed. 916, Circuit Judge, later Chief Justice Taft.

"Control system for an elevator car—

(1) "a plurality of up switches within the car, one for each of a plurality of landings,

(2) "a plurality of up switches without the car, one at each of said landings,"

(It limits and defines the operation of these switches with the statement "both the up switches within the car and the up switches without the car being operable to cause the stopping of the car at the respective landings upon its approaching said landings in the up direction")

(3) "a plurality of down switches within the car, one for each of said landings,"

(4) "a plurality of down switches without the car, one at each of said landings,"

(It limits and defines the operation of these switches with the statement, "both the down switches within the car and the down switches without the car being operable to cause the stopping of the car at the respective landings upon its approaching said landings in the down direction.")

(5) "**switching mechanism within the car,**"

(It limits and defines the operation of this mechanism with the statement, "said switching mechanism being operable to cause the starting of the car from each and every landing in either direction.")

The emphasized portions of this claim show that it has to do with a Control System For An Elevator Car. This statement, as well as the rule of law that a patent claim is to be interpreted in the light of the specification, requires that the claim be read as though it included the elements described in the specification which are controlled by the combination of switches and switching mechanisms covered by this sub-combination claim.*

This is especially so where it appears (as the Master observed, R. 561) that

* *Temco Co. v. Apco Co.* 275 U. S. 319, 329; *Eibel Process v. Minnesota, etc.* 261 U. S. 45; *Paper Bag Patent*, 210 U. S. 405, 417, and other cases cited *infra*, p. 26.

"to obtain this result Parker has taken from the prior art the usual starting circuits"

and (R. 558)—

"intended to use some system of slowing-down, stopping and leveling then in use that could be adapted to his control means,"

for, a patent specification is addressed to those skilled in the art, and it is enough that they would supply what a patent may have omitted.†

An examination of the five elements in claim 37 shows that the Court is in error in stating that the "only means described for accomplishing" the result sought by the invention "are a series of switches *i. e.*, push buttons."

The claim calls for the combination of the following mechanical elements—

- (1) a *plurality* of up switches *within* the car, one for each of a plurality of landings;
- (2) a *plurality* of up switches *without* the car, one at each of said landings;
- (3) a *plurality* of down switches *within* the car, one for each of said landings;
- (4) a *plurality* of down switches *without* the car, one at each of said landings;
- (5) *switching mechanism within* the car.

The first four elements show that they call for a combination of pluralities of up and down stopping switches, the *number* of such switches and the *exact location* of each "to cause the stopping of the car at the respective landings upon its approaching said landings in either the up or down direction."

Element numbered 5 is for a *switching mechanism within the car* operable to cause the starting of the car from

† *Hildreth v. Mastoras*, 257 U. S. 27; *Minerals Separation v. Hyde*, 242 U. S. 261; *Sun Ray Gas Corp. v. Bellows-Claude Neon Co.*, (C. C. A. 6) 49 F. (2d) 886; *American Delinter v. American Machinery Co.*, (C. C. A. 5) 128 Fed. 709, 721; *Remington etc. Co. v. National etc. Co.* (D. Conn.) 6 F. (2d) 585, 619. As the court said in *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428, 443: "In making a combination the inventor has the whole field of mechanics to draw from."

each and every landing in either direction. This element is likewise *limited to the location* of the switching mechanism used for starting the car from each and every landing in either direction. This would not cover starting the car from outside the car as is so frequently done in push button elevators.

The statement by the Court that (p. 11)

"any system controlled by electric switches for accomplishing the same result would clearly have been an infringement"

is clearly erroneous, for numerous other combinations might readily be devised, for causing the stopping of the car at the respective landings upon its approaching said landings in either the up or down direction, than that utilizing the combinations of mechanical elements in this claim which provides for a *plurality* of up switches and down switches *within* the car, *one for each* of said landings, and a *plurality* of up switches and down switches *without* the car, *one at each* of said landings, and for a *switching mechanism* *within* the car operable to cause the starting of the car from each and every landing in either direction. Certainly an elevator construction which did not utilize this *plurality* of switches arranged *within* and *without* the car for stopping the car at the respective landings, and did not locate these switches as defined by the claim, and which did not use these in combination with the *switching mechanism* *within* the car—for starting the car—would not infringe this claim.

Plaintiff's position on this point is supported by the fact that defendants excepted to the Master's report on the ground that—

"The Master erred in not finding that Claims 37, 40, 41 and 65 of the Parker Reissued Letter Patent were deliberately and intentionally restricted to separate up

and down car buttons and therefore could not be interpreted to include a system embodying only a single set of car buttons for both up and down direction.”

This shows that defendants clearly did not consider that “any system controlled by electric switches for accomplishing the same result would clearly have been an infringement”

of claim 37 but, on the contrary

“a system embodying only a single set of car buttons for both upon and down direction,”

for example, would not have been an infringement of that claim.

Further considering claim 37. It is for a *control system* for an elevator car. When reference is made to the specifications as to what this control system is, it is immediately apparent that the plurality of stopping switches and the switching mechanism of this sub-combination claim are a part of an operable combination which necessarily include the primary and secondary circuits and other means through which the car is started, run and stopped. Further, the expressions—

“operable to cause the stopping of the car at the respective landings upon its approaching said landings in the up direction,”

used in connection with the up switches *within* and *without* the car;

“operable to cause the stopping of the car at the respective landings upon its approaching said landings in the down direction,”

used in connection with the down switches *within* and *without* the car; and

“being operable to cause the starting of the car from each and every landing in either direction,”

used in connection with the switching mechanism located *within* the car, each clearly indicates, to anyone experienced in the elevator art, the operative circuits and means whereby the car is run and stopped, the starting and running being initiated by switches *within* the car, and the stopping

in either direction being initiated by *any one of a plurality of switches within the car and at the landings.*

The *sub-combination of elements* in the control system for elevator cars covered by claim 37 are *clearly operable in connection with the "circuits and circuit closing means" shown and described* in the drawings and specifications, and can be readily identified by reference thereto.

When the patentee has shown in his drawings, description and claims the manner of making, constructing and using it in such—

"terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same,"

and has distinguished it from other inventions, he has satisfied the requirements of the statutes.

Having done so, and the public having available to it the complete drawings and specifications, and the means and apparatus shown therein, an inventor may properly cover sub-combinations in different claims, less than the whole invention, and even though this sub-combination is operable only in connection with other operable parts of the system, the claim is nevertheless valid, and the infringer is not entitled to use the sub-combination thus claimed.

As claim 37 is in the form of a number of sub-combination claims which have been sustained by the courts, and as the Patent Office had considered it sufficiently definitive of the invention, and as we have not had occasion to cover this point in this Court prior to its opinion, we hope this Court will give the matter careful consideration.

The statement of the Court that—

"Claim 37 fully states the result to be accomplished by the invention, but the *only means* described for accomplishing it are series of switches, *i. e.*, push buttons"

entirely overlooks the "switching mechanism within the

car". It fails to consider the limitations of the claim to the *plurality* of switches *within* and *without* the car for controlling the movement in either direction of travel and the *exact location of each*. It also fails to appreciate and apply this rule applicable to sub-combination claims that "the circuits and circuit closing means" shown in the drawings and specifications should be read into the sub-combination claim 37 to make it operative especially in view of the language of the claim itself defining the *plurality* of stopping switches as "operable to cause the stopping of the car at the respective landings upon its approaching said landings" in both the up and the down direction, and the language defining the "switching mechanism within the car" as "operable to cause the starting of the car from each and every landing in either direction."

The Court's reference to the Master's comments on claim 29, which he regarded as valid, as distinguishing that claim from claim 37 indicates a too literal interpretation of claim 37, for it predicates the validity of claim 29 (though deemed "more descriptive of function than of the structure") on the presence in it of some language (apparently not found in claim 37), which warrants—

"reading it in the light of the specifications which, in effect limits the claim to those elements of the structure, the function of which is described."

What that language is, unless it be the word "means" or the word "mechanism" is beyond our comprehension, for the "operable" clauses of claim 37 can have no less significance in the construction of a claim than any other language of claim 29, when considered with the mechanical elements, that is, the switches and the switching mechanism, specified in it. These "operable" clauses certainly import all that they would import if revised to specify means to accomplish the result sought under the accepted requirements for the interpretation of claims. The use or non-use of a word such as "means" or "mechanism" in a claim ought not to be, and is not, a distinction between validity

and invalidity of a claim. *Qui haeret in litera, haeret in cortice.* (He who adheres to the letter adheres to the bark.)

The Master, as we have already shown, fully appreciated the meritorious character of the Parker invention. He appreciated that Parker specified the switches and switching mechanism, in claim 37, but that he regarded it as incomplete, because it failed to mention the circuits and circuit closing means which he deemed essential to a definite structure. His mistake lay in not recognizing the claim as one for a sub-combination. But he did not suggest that the claim was functional only.

To regard such a claim as functional only and to hold that "the ambit of the monopoly sought was not thereby made obscure, for any system controlled by electric switches for accomplishing the same result would clearly be an infringement" is obviously a departure from the established canons of decisions.

A SUB-COMBINATION CLAIM NEED NOT SPECIFY A COMPLETE OPERATIVE MACHINE.

Claim 37 amply complies with Section 4888 and is clearly *valid as a sub-combination* under the authorities.

In *Thomson-Houston Elec. Co. v. Black River Traction Co.*, (C. C. A. 2), 135 Fed. 759,* holding complainant entitled to a decree the court (Judge Wallace) said (p. 763):

* In this case the sub-combination claims considered by the court were:
 "(1) In an electric railway, the combination of a car, an overhead conductor above the car, an upwardly extending and laterally swinging arm mounted on the roof of the car, and carrying a contact device at its free end, and making underneath contact with the conductor, substantially as described.

(2) In an electric railway, the combination of a car, an electric overhead conductor above the car and parallel with the line of travel, an upwardly extending trailing arm carrying a contact device at its free end, adapted to make underneath contact with the conductor, said arm being supported on the car on vertical and transverse axes, so as to permit said contact device to follow the position of the conductor, notwithstanding the great variations of height and of lateral displacement thereof, substantially as described."

The court sustained these claims although no tension means for holding the arm and contact device against the conductor was included, stating that such a device was necessary for the operation and was included by implication.

"If the combination now claimed was new and useful, Van Depoele was entitled to make a claim for it, as for a subcombination, notwithstanding additional means may have been necessary to place the specific parts in co-operative relations with the overhead conductor to effect a traveling contact. As the means for doing this are described in the patent, and as at the date of the patent tension devices of various kinds for maintaining the normal relations between the contact device and the overhead conductor were well known in the art, it was unnecessary to specify these means in the claims. * * *

"Many subcombinations, although new, are not useful, except to perform their appropriate functions in the machine of which they are a part. The description in the patent of the whole machine, and of the means or mode by which the subcombination is brought into co-operative relation with the other parts, usually indicates how the subcombination may effect a useful result. When this is so, the combination need not be operative alone, because (to use the language of Mr. Walker) 'utility is justly ascribed to things which have their use in co-operating with other things to perform a useful work.' In *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 309, 22 C. C. A. 203, in considering the objection that the claims by themselves were void because not composing an operative mechanism, the court said:

"The law upon this subject is too well settled to be open for discussion. A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete combination of the spindle and its supporting tube and devices, and there was no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood. The omission of the sleeve wheel does not affect the validity of either of the claims, which belong to that class where reference may be made to the specification to supply in a claim what is plain to any one skilled in the art.'"

In *Wright v. Herring-Curtiss*, 204 Fed. 597 (affirmed 211 Fed. 654, C. C. A. 2), at page 607, in disposing of a similar

contention there made and holding the claim* valid and infringed, the court said:

"It is not essential to the validity of claim 3 that all parts of the machine, or all parts specified in other claims, which are necessary to its operativeness, should be included therein, and resort must be had to the specification for a disclosure of the parts necessary to insure the practicability of a patented device. In the Wright structure a new and novel result was attained simply by having the ailerons on the ends of the planes, without the supplemental feature of the vertical rudder. The warping feature is, in fact, the essential part of the machine, while the vertical rudder, insuring successful flying, is a valuable adjunct, without which lateral balance could not be restored. The employment, in a changed form, of the warping feature or its equivalent by another, even though better effects or results are obtained, does not avoid infringement. In such circumstances, as I read the authorities, the claim is valid as a subcombination. *Thomson-Houston Electric Co. v. Black River Traction Co.*, 135 Fed. 759, 68 C. C. A. 461; *Deering v. Winona Harvester Works*, 155 U. S. 286, 15 Sup. Ct. 1187, 39 L. Ed. 153; *Taylor et al. v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203. In *Railroad Co. v. Dubois*, 12 Wall. 47, 20 L. Ed. 265, the Supreme Court of the United States says:

"Undoubtedly a patentee may claim and obtain a patent for an entire combination, or process, and also for such parts of the combination or process as are new and useful, and he may claim and obtain a patent for both."

* * * * *

* The claim to which the defenses of indefiniteness, incompleteness and inoperativeness were urged was—

"3. In a flying machine, a *normally flat aeroplane having lateral marginal portions* capable of movement to different positions above or below the normal plane of the body of the aeroplane, such movement being about an axis transverse to the line of flight, whereby said lateral marginal portions may be moved to different angles relatively to the normal plane of the body of the aeroplane, and also to different angles relatively to each other so as to present to the atmosphere different angles of incidence, and *means for simultaneously imparting such movement* to said lateral marginal portions, substantially as described."

Although this claim did not include the vertical rudder as an element, which element was necessary to its operativeness, and except for the two italicized mechanical elements, covered the operation and function of these elements, it was held to be a valid sub-combination claim.

"To a similar effect, see *Canda et al. v. Michigan Malleable Iron Co.*, 124 Fed. 486, 61 C. C. A. 194, and *Clark Blade & Razor Co. v. Gillette Safety Razor Co.*, 194 Fed. 421, 114 C. C. A. 383."

This decision was affirmed by the Court of Appeals for the Second Circuit, 211 Fed. 654, the court saying:

"We are in full accord with the reasoning by which he [Judge Hazel] reached the conclusions that the patent in suit is a valid one."

In *Deering v. Winona Harvester Works*, 155 U. S. 286, the court held the patent there sued on valid and infringed. The sub-combination claim under consideration by the court was—

"20. The combination, in a grain-binder, of moving butt-adjusting mechanism and the board d^1 , substantially as described."

In sustaining this claim the court read into it (the additional elements shown in the drawings and set forth in the specifications) the board d^2 pivoted to the butt-adjuster and arms d^2 , d^3 and d^4 , all of which were necessary to render the device operable. Speaking through Mr. Justice Brown, the court said at page 302, in disposing of the defendant's contention there that the claim did not comply with the Revised Statutes:

"Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described * * * be read into the claim."

In order to determine what is meant by "a control system" for an elevator car and a *plurality* of switches *within* and *without* the car being "*operable*" to cause the stopping of the car "at the respective landings" it must be understood that the switches are connected through proper circuits to bring about the desired result. The use of the words "*operable to cause*" in claim 37 necessarily brings in these other operative features when considering the validity of the claim, under the decisions.

In the *Telephone cases*, 126 U. S. 1, the Court had before it for consideration the Bell patents No. 174,465 (p. 4) and No. 186,787 (p. 15). After distinguishing between the claims of the valid Bell patent No. 174,465 and claim 8 of Morse held invalid in the *O'Reilly v. Morse* case and demonstrating, we think, that claim 37 is not for a function only, the Court also considered the second Bell patent No. 186,787, which had to do with separate elements in an electric telephone and for a sub-combination of such elements. Three of the claims of this second Bell patent No. 186,787 were:

3. "The combination, with an electro-magnet, of a plate of iron or steel, or other material capable of inductive action, which can be thrown into vibration by the movement of surrounding air or by the attraction of a magnet

6. The combination, with an electric telephone such as described, of a sounding-box, substantially as herein shown and set forth.

7. In combination with an electric telephone, as herein described, the employment of a speaking or hearing tube for conveying sounds to or from the telephone, substantially as set forth.

8. In a system of electric telephony, the combination of a permanent magnet with a plate of iron or steel, or other material capable of inductive action, with coils upon the end or ends of said magnet nearest the plate, substantially as set forth."

With respect to these claims, the Court said (p. 572):—

"The patent itself is for the mechanical structure of an electric telephone to be used to produce the electrical action on which the first patent rests. The third claim is for the use in such instruments of a diaphragm, made of a plate of iron or steel, or other material capable of inductive action; the fifth of a permanent magnet constructed as described with a coil upon the end or ends nearest the plate; the sixth of a sounding box as described; the seventh of a speaking or hearing tube as described for conveying the sounds; and the eighth of a permanent magnet and plate combined. The claim is not for these several things in and of themselves,

but for an electric telephone in the construction of which these things or any of them are used."

These statements by the Supreme Court in the Telephone cases show that the Supreme Court has consistently held that (12 Wallace 265)

"a patentee may claim and obtain a patent for the entire combination or process and also for such parts of the combination or process as are new and useful, and he may claim and obtain a patent for both,"

and

"admitting that additional elements are necessary to render the device operative, it does not necessarily follow the omission of these elements invalidates the claim or that the precise elements described be read into that claim." (155 U. S. 286.)

In *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301 (C. C. A. 3), the court in holding the claim there involved valid and infringed, said at p. 309:

*"A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete combination of the spindle and its supporting tube and devices, and there was no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood. The omission of the sleeve whirl does not affect the validity of either one of the claims, which belong to that class where reference may be made to the specifications to supply in a claim what it is plain, to any one skilled in the art, is a necessary incident. *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 10 C. C. A. 194, 61 Fed. 970; *Deering v. Harvester Works*, 155 U. S. 286, 15 Sup. Ct. 118. The decree of the circuit court is affirmed."*

The sub-combination claims involved were:—

"(3) The combination, substantially as hereinbefore described, of a spindle rail of a spinning machine, a spindle, and a supporting tube flexibly mounted with relation to the spindle rail, and containing steps and bolster bearings.

(4) The combination, substantially as hereinbefore

described, of a spindle rail, a spindle, a supporting tube containing step and bolster bearings, flexible connections between said tube and the spindle rail, and adjusting devices for varying the degree of flexibility of the supporting tube and spindle therein.

(5) The combination of the spindle rail, the spindle, the supporting tube, loosely mounted with relation to the rail, and containing the step and bolster bearings for the spindle, the spring, and the nut for compressing it, substantially as described."

The above claims were held valid in spite of the fact that the inclusion of the sleeve whirl was necessary to make them operative. This element, shown and described, was held to be included, in the claim by implication, as a "necessary incident."

In *Roberts v. H. P. Nail Co.*, (N. D. Ohio), 53 Fed. 916, the late Chief Justice Taft (then circuit Judge), had under consideration the following sub-combination claim:—

"(1) In apparatus for coiling metal, a rotary receiving and coiling cone, having a channel which receives the metal at the smaller end or apex, and delivers it at its base, in combination with mechanism for rotating the cone, substantially as and for the purposes described."

He held this claim valid in spite of the fact that it did not include the entire mechanism, shown and described, necessary to its operation.

He said (p. 920):

"Counsel for respondent earnestly object to the validity of the first claim in the first Roberts patent on the ground that is for a single cone, with a channel, receiving the metal at its smaller end, and delivering it at its base, in combination with mechanism for rotating it; while the specifications show only a double cone,—that is, show an inner cone, with a channel made up of a single rib and an outer cone. It is said that it is not permissible for a patentee to make claim for a mechanism wider than anything which is shown to be operative in his specifications. The other claims of the patent are for a double cone, so that it is clear that the first claim is only for a single cone. Nevertheless I do not think that the point is well taken. *In*

a combination patent it is permissible for the patentee, after claiming his whole machine, to claim also the combination of fewer parts than the whole, provided the combination of the parts is new, even if, taken alone, the combination will not result in any known useful product. This is fully established in the decision of Judges McKennan and Nixon in the case of *Wells v. Jaques*, 5 O. G. 364. In that case the patent was for a combination of elements marking up a hat-body machine. The combination embodied a great many different parts, and the patentee made quite a number of claims, of which one only embodied the whole machine. It was objected that only the claim for the whole machine was valid, because the devices in combination in the other claims could not be employed alone for any useful purpose, and, only being useful when combined into a complete machine, the patent should have been for the unit, and not for the different combinations. To this objection Judge Nixon says:

“ ‘I cannot yield assent to that proposition. The separate claims of a patent must be construed in reference to the specifications; and, if the specifications point out the arrangements to be made, or the methods to be adopted, in connection with other instrumentalities which the inventor may not claim as new, in order to render his invention practically useful, the test to be applied is not whether the claim alone will produce a useful result, but whether it will do so supplemented by and in connection with such designated devices and instrumentalities.’ ”

“In 2 Rob. Pat. Sec. 530, the principle is stated thus:

“ ‘Claims for each subordinate piece of mechanism may be joined with those for the principal machine, though not capable of use in any other known connection.’ ”

“A little reflection shows that this cannot be otherwise, in view of the strict rule applying against the patentee of a combination, on the question of infringement. The omission by the respondent from the combination of complainant of a single element, whether that be old or new in itself, defeats the claim of in-

fringement. That patentees may properly protect what is really new in the combination, they must therefore be given the opportunity to select out a part or parts which are new, less than the whole working machine, and by their claims warn the public against the use of them in any other combination to accomplish the same general result as that for which they were used by the patentee in his complete machine."

The right of an inventor to claim the entire combination and parts thereof as well, was also recognized in *Railroad Co. v. Dubois*, 12 Wall. 47, 60.

In *Chambers-Bering-Quinlan v. Faries*, 64 Fed. 587, (C. C. Ill.) Judge Allen, in holding the sub-combination claim there asserted valid and infringed, said at p. 588:

"The defense relied on for the sixth claim is that it is for an inoperative combination. Anticipation is not asserted. This objection is not well taken, as the law is well settled that a valid combination claim may be taken for a less number of parts than are required for the complete operation of a machine. *Forbush v. Cook*, 2 Fish. Pat. Cas. 668, Fed. Cas. No. 4,931; *Inspirator Co. v. Jenks*, 21 Fed. 911; *Jenkins v. Gurney*, 23 Fed. 898; *McDonald v. Whitney*, 24 Fed. 600."

In *Hancock Inspirator Co. v. Jenks*, 21 Fed. 911, (C. C. Mich.), Judge (later Justice) Brown in disposing of defendants' contention there that the claim asserted did not comply with the Revised Statutes, said at p. 915:

"Now, while it is entirely true that the combination stated in these claims would be obviously inoperative without such induction tube and chamber, still, by adding these elements, the construction would be equally inoperative without a boiler to furnish the steam and a well to supply the water, and a pipe leading to and from the boiler. But, in drawing the claims for a combination patent, we do not understand it to be necessary to include any elements except such as are essential to the peculiar combination, and are affected by the invention. Other portions of the machine are usually shown in the drawings to exhibit their relation to the patented combination, and they

are wholly unnecessary to the validity of the claims. Indeed, it is manifest that the more elements introduced into the combination, the easier it would be to evade the patent; since, to sustain a suit for infringing a combination, it must be made to appear that the defendant used every element of such combination, however immaterial it may be. *Vance v. Campbell*, 1 Black, 429."

The claims of the invention were—

"(1) The combination of plug, E, with orifice, K, and the tube, C, with the chamber, *e d*, when they are located relatively to each other, substantially as described;

(2) the plug, E, with orifice, K, and tube, C, with the chamber, *e d*, and chamber, *d g*, as described;

(3) the combination, with the above, of the tube, D, substantially as described."

It was contended that the combination claimed would not operate without the addition of an induction tube and a chamber to enclose the tube C. The court in holding these claims valid said (p. 916):

"It is usual in the drawings to show the relations of the patented combinations to the other portions of the machinery, but the patentee is not obliged and ought not to claim anything more than such portions of the combinations as are essentially a part of his invention."

We submit that claim 37 is for a proper sub-combination of mechanical elements within the definition of the above cited cases and does not cover a function only.

A COMPARISON OF CLAIM 37 WITH NUMEROUS CLAIMS CONTAINING FUNCTIONAL STATEMENTS WHICH HAVE BEEN HELD VALID BY THE SUPREME AND OTHER COURTS OVER THE CONTENTION THAT THEY WERE FUNCTIONAL DEMONSTRATES THE VALIDITY OF THIS CLAIM.

We have already shown that claim 37 is for a proper sub-combination, and we desire to call attention of the Court to authorities, in addition to those discussed under the preceding heading, which should make it apparent that

this claim is not invalid because it covered only a function, and that its invalidity is not apparent from a reading of the Master's finding with respect thereto.

The only cases cited by the Court to support its position that—

“Even a casual reading of the claim and the Master's finding discloses that the invalidity [of claim 37] was not merely because of indefiniteness but because it covered only a function”

are *Wyeth v. Stone*, *O'Reilly v. Morse*, and *Holland v. Perkins*.

The claims held invalid in each of these cases were purely for results and were not sub-combination claims of the type here involved. They were not limited to a combination of mechanical elements for performing certain mechanical operations, described and shown, for accomplishing certain results, but merely for the use of “any other power than human” in the Wyeth case, of “magnetism as a motive power” in the Morse case, irrespective of means or mechanism for utilizing such power. This is shown by the claims involved in these cases and by the opinions of the courts, and which in the *O'Reilly v. Morse* case, clearly distinguishes between claim 8 which was purely for results and the other claims, which included means for performing functions.

In *Wyeth v. Stone* the claim in question reads:

“It is claimed as new to cut ice of a uniform size by means of an apparatus worked by any other power than human. The invention of that art as well as the particular method of application of the principle are claimed by the subscriber.”

In the *O'Reilly v. Morse* case, the eighth claim, held invalid because covering results only, read:

“I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the use of the motive power of the

electric or galvanic current, which I call electro-magnetism, however developed, for marking or printing intelligible characters, signs or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer."

In both of these claims, the patentee attempted to cover any means by which the result sought could be secured, and thereby covered the results of any machine or apparatus utilized for the purpose, and by their language expressly attempted to cover any device which would accomplish the result regardless of whether it was shown in the drawings or description or the equivalent of this, and thereby claimed the result or function of any machine by which the stated results could be accomplished.

In order to bring the instant case into apposition to the claims held invalid in the cases of *Wyeth v. Stone* and *O'Reilly v. Morse*, Parker, contrary to the fact, must have claimed any electrical mechanism for starting or stopping an elevator car at any landing, whether described in his specification or not.

Claim 37 of the Parker patent is of an entirely different character from either of these claims.

In the first place, this claim is limited to a control system for an elevator car. It is likewise limited to up switches and down switches *located at definitely specified places, within and without* the car for causing the car to stop at predetermined landings, and to switching mechanism *within* the car to cause the starting of the car from each and every landing in either direction.

Under numerous decisions where such positive elements are included in the claim as here and their locations defined, the claim is not to be held invalid simply because it includes statements of the manner under which they operate, nor as we have pointed out, is such a sub-combination claim to be held invalid simply because it does not include

all of the parts shown in the description or drawings which are necessary for the operation of the combination.

It will be recalled that in *O'Reilly v. Morse* claim 8 of the Morse patent, which has been considered, was the only claim of the eight claims before the court held invalid. *The remaining claims were held to be valid.* A comparison of them with claim 37 of the Parker patent clearly substantiates plaintiff's contention that it is for a sub-combination of mechanical elements and not for a result or function only.

Morse's first claim (56 U. S. 85) read:

"First. Having thus fully described my invention, I wish it to be understood that I do not claim the use of the galvanic current, or current of electricity, for the purpose of telegraphic communications, generally; but what I specially claim as my invention and improvement, is making use of the motive power of magnetism, when developed by the action of such current or currents, substantially as set forth in the foregoing description of the first principal part of my invention, as means of operating or giving motion to machinery, which may be used to imprint signals upon paper or other suitable material, or to produce sounds in any desired manner, for the purpose of telegraphic communication at any distances."

The only language of claim in it is the underscored part and that is limited only by the expression—

"substantially as set forth in the foregoing description of the first principal part of my invention"

and that is true also of the other seven claims. Such a limitation though not expressed, is equally implied in the case of claim 37 of the Parker patent.

"The phrase, 'substantially described or its equivalent,' when such phrase occurs in a claim, throws the investigator back to the description for means of construction, and that phrase is always implied in claims wherein it is not expressed."

Walker on Patents, Sixth Edition, page 308, Section 227, and cases there cited.

Temco Co. v. Apco Co., 275 U. S. 319, 329;

Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45;

Paper Bag Patent, 210 U. S. 405, 417;

Westinghouse v. Boyden, 170 U. S. 537, 557.

Railroad Co. v. Dubois, 12 Wall. 47, 62;

Bates v. Coe, 98 U. S. 31;

Diamond v. S. E. Carr (C. C. A. 9) 217 Fed. 400;

Foamite-Childs Corp. v. Pyrene Mfg. Co. (D. C. Del.) 21 F. (2d) 854, aff'd. (C. C. A. 3) 35 F. (2d) 287;

Gilchrist Co. v. Kar-Lac Co., (C. C. A. 7) 29 F. (2d) 153;

I. T. S. Rubber Co. v. Panther Rubber Mfg. Co. (C. C. A. 1) 260 Fed. 934;

Davis etc. Co. v. New Departure Mfg. Co. (C. C. A. 6) 217 Fed. 775, 783.

The Telephone Cases.

Thirty-three years after the decision in *O'Reilly v. Morse*, the Bell patent came before the Supreme Court, in the *Telephone cases*, 126 U. S. 1. The defendant relied upon *O'Reilly v. Morse* in an attempt to defeat the claims of that patent on the ground that they were invalid because covering the general results sought only. In the Telephone cases the court plainly distinguishes between a claim of the type held invalid in *O'Reilly v. Morse* and that before it.

Among the Bell claims under consideration by the Supreme Court were:

Patent No. 174,465 (126 U. S. 13).

“1. A system of telegraphy in which the receiver is set in vibration by the employment of undulatory currents of electricity, substantially as set forth.

“5. The method of, and apparatus for, transmitting

vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth."

Patent No. 186,787 (126 U. S. 16) :

3. "The combination, with an electro-magnet, of a plate of iron or steel, *or other material capable of inductive action, which can be thrown into vibration by the movement of surrounding air or by the attraction of a magnet.*"

6. The combination, with an electric telephone such as described, *of a sounding box*, substantially as herein shown and set forth.

7. "In combination with an electric telephone, as herein described, the *employment of a speaking or hearing tube* for conveying sounds to or from the telephone, substantially as set forth."

8. "In a system of electric telephony, the combination of a *permanent magnet with a plate of iron or steel, or other material capable of inductive action*, with coils upon the end or ends of said magnet nearest the plate, substantially as set forth."

That these claims, as well as other claims before the court in the Telephone cases, are much more functional than claim 37 of the Parker patent and it is not invalid because it covers only a function, seems too obvious for discussion, particularly in view of the court's discussion of the *O'Reilly v. Morse* case, where it said in discussing claims 1 and 5 of patent No. 174,465 (p. 534) :

"In *O'Reilly v. Morse*, 15 How. 62, it was decided that a claim in broad terms (p. 86) for the use of the motive power of the electric or galvanic current called 'electro-magnetism, however developed, for making or printing intelligible characters, letters, or signs, at any distances,' although 'a new application of that power' first made by Morse, was void, because (p. 120) it was a claim 'for a patent for an effect produced by the use of electro-magnetism, distinct from the process or machinery necessary to produce it;' but a claim (p. 85) for 'making use of the motive power of magnetism, when developed by the action of such current or currents, substantially as set forth in the foregoing description, * * * as means of operating or giving

motion to machinery, which may be used to imprint signals upon paper or other suitable material, or to produce sounds in any desired manner, for the purpose of telegraphic communications at any distances,' was sustained. The effect of that decision was, therefore, that the use of magnetism as a motive power, without regard to the particular process with which it was connected in the patent, could not be claimed, but that its use in that connection could."

"In the present case the claim is not for the use of a current of electricity in its natural state as it comes from the battery, but for putting a continuous current in a closed circuit into a certain specified condition suited to the transmission of vocal and other sounds, and using it in that condition for that purpose."

In referring to the claims of patent No. 186,787, the Court said (p. 572) :—

"The patent itself is for the *mechanical structure of an electric telephone* to be used to produce the electrical action on which the first patent rests. The third claim is for the use in such instruments of a diaphragm, made of a plate of iron or steel, or other materials capable of inductive action; the fifth of a permanent magnet constructed as described with a coil upon the end or ends nearest the plate; the sixth of a sounding box as described; the seventh of a speaking or hearing tube as described for conveying the sounds; and the eighth of a permanent magnet and plate combined. *The claim is not for these several things in and of themselves, but for an electric telephone in the construction of which these things or any of them are used.*"

So in the instant case claim 37 of the Parker patent

"is not for the several things (*i. e.*, the switches and the switching mechanism) in and of themselves," but for "*a control system*"

in which these things (*i. e.*, the switches and switching mechanism) are used, as a sub-combination of mechanical elements forming a part of the complete invention of the Parker patent.

These statements of the Supreme Court point out a dis-

tinction which this Court failed to appreciate with respect to claim 37 where this Court says it is for a function only. This claim in fact covers a sub-combination of mechanical elements which together with their method of operation and use, in a control for an electric elevator, are clearly shown and described in the patent. That such a claim clearly is not a functional one under *O'Reilly v. Morse* is clearly shown by the opinion in that case with respect to claims other than 8, and by the opinion of the Supreme Court in the Telephone cases. Numerous other cases support this proposition.

The Following Cases Are Among Those in Which Defendants Have Made the Contention That the Claims Are Functional, and Despite This the Supreme and Other Courts Have Held Them Proper Claims and Not Invalid Because They Cover a Function Only.

In citing these cases we have in most instances copied the claims which were actually before the court for its consideration, so that this Court may, without spending undue time, compare the language of these claims, with claim 37 of the Parker patent, and appreciate that claims containing more functional statements concerning included elements, than claim 37 have been repeatedly held valid.

We ask that the Court compare claim 37 of Parker with its combination of elements and statements of the result to be accomplished by each, with claim 12 of the Eibel patent 845,224, sustained by the Supreme Court in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45. Among the six claims considered by the court was claim 12 which reads as follows:

“12. In a Fourdrinier machine, a downwardly-moving paper-making wire, the declination and speed of which are so regulated that the velocity of the stock down the declining wire, caused by gravity, is so related to the velocity of the wire in the same direction, that waves and ripples on the stock are substantially

avoided and the fibers deposited with substantial uniformity on the wire, substantially as described."

In considering this claim and in holding it valid, the late Chief Justice Taft says (p. 71):

"This comes nearer to being a process claim but whether it is or not the defendant infringes it."

In this *Eibel Co. v. Paper Co.* case the *only element positively included was a downwardly-moving paper-making wire in a Fourdrinier machine.* All of the rest of the claim related to the functional regulation of the declination and speed of this paper-making wire, by which the waves and ripples on the stock are substantially avoided and the fibres deposited with substantial uniformity on the wire.

Comparing claim 12 of the Eibel patent, sustained by the Supreme Court, with claim 37 of the Parker patent, the mechanical elements appearing in each are:

EIBEL PATENT

"In a Fourdrinier machine,

(a) a downwardly-moving paper-making wire,

PARKER PATENT

"A control system for an elevator car comprising,

(a) a plurality of up switches within the car, one for each of a plurality of landings.

(b) a plurality of up switches without the car, one for each of a plurality of landings,

(c) a plurality of down switches within the car, one for each of said landings,

(d) a plurality of down switches without the car, one at each of said landings,

(e) switching mechanism within the car.

The functional statements defining the operation of the above elements, the combination of a plurality of up and down switches *without* the car, one at each landing, and a plurality of up and down switches *within* the car, is that they are "operable to cause the stopping of the car at the respective landings" in either the up or down direction, and that the switching mechanism within the car is "operable to cause the starting of the car from each and every landing in either direction."

The functional statement contained in this claim following the two above recited mechanisms reads:

"The declination and speed of which are so regulated that the velocity of the stock down the declining wire, caused by gravity, is so related to the velocity of the wire in the same direction, that waves and ripples on the stock are substantially avoided and the fibers deposited with substantial uniformity on the wire, substantially as described."

A comparison of these two claims shows that where in the Eibel patent there was simply one mechanical element qualified by a statement of operation. In the Parker patent there is the combination of five mechanical elements qualified by a statement of the operation of each. In both the Eibel and the Parker claims the statement of operation or function imports into the claim the additional elements necessary to make it a complete operative mechanism. In the Eibel case the Court had to read into this claim the means, in a Fourdrinier machine, for giving and regulating the speed of the downwardly moving paper making wire to make the device operative. Such a reading of "circuit and circuit closing means" into the Parker claim 37 must render it valid.

As the Supreme Court has held claim 12 of the Eibel patent valid over the insistence that it was functional only, there can be no question whatever that claim 37 of the Parker patent can withstand the same test and is not invalid because it covered only a function. It covers a sub-combination of mechanism as well as a statement of the result which is accomplished by each and not a function only.

In *Hildreth v. Mastoras*, 257 U. S. 27, the Dickinson patent for a candy-pulling machine was involved. The late Chief Justice Taft writing the opinion of the court and sustaining Dickinson's claim, again approved and sustained claims containing just such statements as are in claim 37 of the Parker patent. The claim there involved reads (p. 32):

"A candy-pulling machine comprising a plurality of oppositely-disposed candy hooks or supports, a candy-puller, and means *for producing a specified relative in-and-out motion of these parts for the purpose set forth.*"

The italicized portion of this claim certainly contains a statement of function, quite as much as claim 37 of Parker.

The Supreme Court held the machine patented as embodying (p. 34)—

“the generic principle, and works, that is, if it actually and mechanically performs, though only in a crude way, the important function by which it makes the substantial change claimed for it in the art,”

and that it was, therefore, a pioneer. Citing *Telephone Cases*, 126 U. S. 1, 535; *Mergenthaler Linotype Co. v. Press Publishing Co.*, 57 Fed. 502, 505.

In *Paper Bag Patent Case*, 210 U. S. 405 (1908) the claims involved were the first, second and seventh, of which the first is representative and is as follows (p. 417):

“In a paper bag machine, the combination of a rotating cylinder provided with one or more pairs of side forming fingers adapted to be moved toward or from each other, a forming plate also provided with side forming fingers adapted to be moved toward or from each other, means for operating said fingers at definite times during the formative action upon the bag tube, operating means for the forming plate adapted to cause the said plate to oscillate about its rear edge upon the surface of the cylinder during the rotary movement of said cylinder, the whole operating for the purpose of opening and forming the bottom of the bag tube, and means to move the bag tube with the cylinder.”

These claims were held to be valid by the Circuit Court, which holding was affirmed by the Circuit Court of Appeals for the First Circuit and by the Supreme Court:

As stated by the Circuit Court (p. 417):

“The pith of the invention is the combination of the rotary cylinder with means of operating the forming plate in connection therewith, limited, however, to means which cause the plate to oscillate about its rear edge.”

The Supreme Court said (p. 421):

“Counsel, however, contends that the Circuit Court, in its decision, virtually gave Liddell a patent for a function by holding that he was entitled to every means

to cause the forming plate to oscillate about its rear edge.

"The distinction between a practically operative mechanism and its function is said to be difficult to define. Robinson on Patents, sec. 144, *et seq.* It becomes more difficult when a definition is attempted of a function of an element of a combination which are the means by which other elements are connected and by which they coact and make complete and efficient the invention. But abstractions need not engage us. The claim is not for a function, but for mechanical means to bring into working relation the folding plate and the cylinder. This relation is the very essence of the invention, and marks the advance upon the prior art."

Certainly if this distinction between "a practically operative mechanism and its function" is "difficult to define" and "more difficult" where a functional statement relates to an element of a combination, this Court should not strike down a valid patent on a finding of what the Master held with respect to claim 37 where certainly the Master does not make it clear that this claim is for a function only, and where the decisions show it to be a proper sub-combination.

In *Cimiotti Unhairing Company v. American Fur Refining Company*, 198 U. S. 399, which the Supreme Court cites in the Paper Bag Case above referred to, the court approved and sustained the following claim, which contains statements showing the purposes to be served or the results accomplished, and shows that claims containing such statements are not invalid because functional.

"8. The combination of a fixed stretcher-bar, means for intermittently feeding the skin over the same, a stationary card above the stretcher-bar, a rotary separating-brush below the same, and mechanism, substantially as described, whereby the rotary brush is moved upward and forward into a position in front of the stretcher-bar, substantially as set forth." (p. 409)

The court after approving this claim says (p. 410):

"In making his claim the inventor is at liberty to choose his own form of expression, and while the courts

may construe the same in view of the specifications and the state of the art, they may not add to or detract from the claim."

In *Keystone Manufacturing Company v. Adams*, 151 U. S. 139, the Supreme Court in sustaining the Adams patent of October 15, 1872, for an improved corn-sheller, again approves just such statements and claims as are here criticized.

The claim held valid by the court read (p. 142) :

"The combination with a cornsheller of a series of wings, wheels, or projections, *so arranged on a shaft as to revolve in the same direction which the corn is running, and so placed relative to the throat as to force into the machine all misplaced or hesitating ears, substantially as specified.*"

In *Expanded Metal Company v. Bradford*, 214 U. S. 366, the single claim of the Golding patent of October 9, 1894, for an expanded sheet metal, read as follows (p. 377) :

"The herein described method of making open or reticulated metal work, which consists in simultaneously slitting and bending portions of a plate or sheet of metal *in such manner as to stretch or elongate the bars connecting the slit portions and body of the sheet or plate, and then similarly slitting and bending in places alternate to the first-mentioned portions, thus producing the finished expanded sheet metal of the same length as that of the original sheet or plate, substantially as described.*"

The court in approving this claim says (p. 377) :

"It is thus apparent that the method covered by the claim of the patent is accomplished by the two operations indicated and performed in the manner pointed out in the specifications."

(p. 379) "But the patent in suit, embraced in the claim allowed, shows more than a mere method of making open meshes by simultaneously cutting and stretching the metal. It shows a method by which the metal is first cut and stretched in the manner indicated to make the half diamond, and then a second operation,

coordinating with the first and completing the mesh by the manner in which it is performed in connection with the first. It is the result of the two operations combined which produces the new and useful result covered by the claim allowed in the Patent Office, and, which, when read in connection with the specifications, shows substantial improvement in the art of making expanded metal work."

The court further says (p. 381) :

"The important thing in this patent is a method of procedure, not the particular means by which the method shall be practiced."

In *Morley Sewing Machine Co. v. Lancaster*, 129 U. S. 263 (1889), claims of this type were upheld by the Supreme Court reversing the decree of the Massachusetts Circuit Court. Claim 1 is representative and is as follows (p. 266) :

"The combination, in a machine for sewing shank-buttons to fabrics, of button-feeding mechanism, *appliances for passing a thread through the eye of the buttons and locking the loop to the fabric*, and feeding mechanism, substantially as set forth."

The court said at page 286:

"Those claims are not for a result or effect, irrespective of the means by which the effect is accomplished. It is open to a subsequent inventor to accomplish the same result, if he can, by substantially different means. The effect of the rule before laid down is merely to require that, in determining whether the means employed in the Lancaster machine are substantially the same means as those employed in the Morley machine, the Morley patent is to receive a liberal construction, in view of the fact that he was a pioneer in the construction of an automatic button-sewing machine, and that his patent, especially in view of the character and terms of the four claims in question, is not to be limited to the particular devices or instrumentalities described by him, used in the three main elements of his machine, which, combined together, make it up. This is the principle applied by this court in *Consolidated Valve Co. v. Crosby Valve Co.*, 113 U. S. 157."

In *Von Schmidt v. Bowers*, 80 Fed. 121 (C. C. A. 9), a decision of this Court and a leading case in this Circuit, contention was made that complainant's claims were for functions and results and constituted merely aggregations. Firmly turning down this contention, this Court said, p. 147 *et seq.*:

"By section 4888 of the Revised Statutes it is provided that every inventor, when making his application for a patent, shall file in the patent office a written description of his invention; and, if the application be for a machine, he is required to explain the principle thereof, and the best mode in which he has contemplated applying the principle, so as to distinguish it from other inventions. But he is not necessarily limited to the one mode shown. The pioneer inventor is entitled to a generic claim, under which will be included every species included within the genus. In addition to such generic claim, he may include in the same application specific claims for one or more of the species. *Machine Co. v. Lancaster*, 129 U. S. 263, 9 Sup. Ct. 299; *Clough v. Barker*, 106 U. S. 166, 1 Sup. Ct. 188; *Clough v. Manufacturing Co.*, 106 U. S. 178, 1 Sup. Ct. 198; Rob. Pat. Sec. 535; *Hammerschlag v. Scamoni*, 7 Fed. 584; *Telephone Co. v. Spencer*, 8 Fed. 509; *Machine Co. v. Teague*, 15 Fed. 390; *Manufacturing Co. v. Buffalo*, 20 Fed. 126; *Brush Electric Co. v. Electric Imp. Co.*, 52 Fed. 965; *Ex Parte Nagle* (1870), Com. Dec. 137; *Ex Parte Howland*, 12 O. G. 889.

"When the complainant claimed, in claim 10 of his patent 318,859, 'dredge boat having a self-contained pivot, forming a center of horizontal oscillation, with devices for swinging and working said boat upon said pivot, in combination with a suction pipe, exhausting apparatus, and rotary excavator,' he was not claiming a result, which, of course, he could not do. Nor did he thereby limit himself to any particular form of construction of the several devices therein mentioned. What he there claimed, and what he, as the first inventor of any combination that would accomplish the desired result had a right to claim, was the combination of a dredge boat itself containing a pivot forming a center of horizontal oscillation, with devices for swinging and for working the boat on the pivot, a ro-

tary excavator for the severing of the material in place, a suction pipe for its receipt and transmission to the exhausting apparatus, and the latter for the transportation and discharge of the spoils to the desired place of deposit. The record shows that the complainant was the first to combine those elements at all, and that the functions performed by his machine so constructed were entirely new. Hence he had the right to make the broad and generic claim embodied in claim 10, without any limitation as to the form of construction of the particular elements, and all subsequent machines which employ substantially the same means to accomplish the same result are infringements, notwithstanding the subsequent machine may contain improvements in separate mechanism which go to make up the machine. Authorities, *supra*, and *McCormick v. Talcott*, 20 How. 402; *Railway Co. v. Sayles*, 97 U. S. 554; *Clough v. Barker*, 106 U. S. 166, 1 Sup. Ct. 188; *Consolidated Safety-Valve Co. v. Crosby Steam Gauge & Valve Co.*, 113 U. S. 157, 5 Sup. Ct. 513. Of course, it remained open to any subsequent inventor to accomplish the same result by substantially different means."

In *Bake-rite Mfg. Co. v. Tomlinson et al.*, 16 F. (2d) 556, C. C. A. 9 (1926), the following claim, previously held valid by the District Court, was upheld (p. 556) :

" 'In an apparatus of the character described (a) a receptacle for hot grease; (b) mechanism for turning doughnuts or the like over after they have been in a separate receptacle for a predetermined length of time; (c) a mechanism for thereafter removing them after they have been cooked for a further predetermined length of time.' "

The court said (p. 557) :

"It is also argued that Tomlinson's patent is invalid, because it is an attempt merely to patent a principle, function, or result. Appellants cite authorities holding that a patent covering generally any and every means or mechanism or method producing a given result is void as an attempt to patent a principle. That rule, undoubtedly generally correct, is inapplicable here, for the reason that Tomlinson claims a combina-

tion of means which operate together to perform a certain function. *Morely Machine Co. v. Lancaster*, 129 U. S. 263, 9 S. Ct. 299, 32 L. Ed. 715; *Denning Wire & Fence Co. v. American Steel & Wire Co.* (C. C. A.) 169 F. 793.' "

These rules of patent construction have been reflected in comparatively recent decisions of the Supreme Court.

In *Temco Co. v. Apco Co.*, 275 U. S. 319, reversing the Circuit Court of Appeals and the District Court, and holding a patent for a spring device valid and infringed, in an opinion by Chief Justice Taft, the court said (p. 329) :

"The district court and the Circuit Court of Appeals in this case held that claim No. 3 of the patent in suit was void because inoperative and having no description upon which it could be properly used as a claim. The claim is as follows:

'In automobile construction, wherein coiled springs are used auxiliary to leaf springs for absorbing shock to the road wheels, the combination of upright stanchions with the axle of the ground wheels, said stanchions being attached to the outer ends of said axle, leaf springs extending above the axle and between the stanchions, and supporting the chassis frame, the said stanchions being adapted to limit the end motion of the leaf springs and thereby prevent side sway of the chassis frame, hangers for the outer ends of said leaf springs, said hangers having a vertical movement and being guided therein by said stanchions, and coiled springs interposed between said leaf spring hangers and said axle of the ground wheels.'

"The district court in its opinion said: 'For want of any statement as to how the leaf spring and helical spring are to be connected to and guided by the stanchions, I think Claim 3 is incomplete and void.'

"The Circuit Court of Appeals of the Fifth Circuit said of the claim: 'Appellee (the petitioner) has filed a cross-appeal and insists that the claim which the district court disallowed is valid. That claim is about as vague as it could be made. As pointed out by the district judge it fails to specify the means by which the

leaf and helical springs can be connected to and guided by the stanchion. To sustain a claim as general as this is would be to allow a patent for a "result and not for the mechanism producing it".'

"Reading the claim with the specifications and the drawings, which are both clear (*Howe Machine Co. v. National Needle Co.*, 134 U. S. 388, 394) its addition to the combination of coiled springs interposed between the leaf spring hangers having vertical movement and guided by stanchions, comprehends the link as shown in the drawings, or any suitable connection between each leaf spring and its hanger and casing surrounding the coiled spring which is interposed between the leaf spring and the axle and ground wheel. It does not seem to us that the claim is vague; nor do we find nullifying incompleteness in it."

CLAIM 37 IS OF THE TYPE COMMONLY USED IN THE ELECTRICAL AND ELEVATOR ARTS AND HAVE BEEN REPEATEDLY SUSTAINED BY THE COURTS.

Claims of the same type as claim 37 have almost universally been used in connection with securing patents covering electrical inventions, and have been repeatedly sustained by the courts in this art as well as in the elevator art. To illustrate:

In *Plunger Elevator Co. v. Standard Plunger Elevator Co.*, 165 Fed. 906, the Circuit Court of Appeals for the First Circuit, speaking through Circuit Judge Lowell, reversed the Circuit Court and sustained the Cole patent No. 700,740 holding the claims valid and infringed. The following claims fairly illustrate the scope of the invention—

"(2) The combination with the main three-way valve, of means for opening and closing said valve in either direction, and automatic means for regulating the opening and closing movements at different rates of speed.

"(3) The combination with the main valve for controlling the passage of fluid under pressure, of means for opening and closing said valve, and automatically-

operated quick-opening, slow-closing means connected with said main valve, whereby the speed of opening and the speed of closing the main valve are regulated within independent limits, substantially as described.

"(4) In a hydraulic elevator the combination with a main valve, of a valve-motor, a pilot-valve mechanism, and an opening and closing regulating means operated by movement of the main valve, whereby a quick opening and a slow closing of the main valve are effected.

"(5) The combination with the main valve for controlling the passage of fluid under pressure, of motor means for opening and closing said main valve, secondary valve mechanism for controlling the motor means, and hydraulic opening and closing regulating means for automatically regulating the velocity at which the main valve may be opened and the velocity at which the main valve may be closed at independent rates, substantially as described."

In *Otis Elevator Co. v. Kaestner & Hecht Co.*, 234 Fed. 926 (D. C. Ill.), District Judge Sanborn held claims 18, 19, 20 and 21 of the Herdman patent No. 548,830 valid and infringed. These claims as set forth in the opinion are as follows (p. 934):

"Claims 18. The combination with an electric motor and a source of current supply—

- (1) Of a device controlled by the motor,
- (2) And, adapted after a predetermined number of revolutions of the motor.

(3) To change the relation to each other of the strength of the current passing to the armature and field independent of the operating mechanism.

"Claim 19:

- (1) Same.
- (2) Same.

(3) To increase the strength of current passing to the field of the motor independent of the operating mechanism.

"Claims 20 and 21 are substantially like 18."

In this case also claims 9 and 10 of the Sprague patent No. 815,756 were held valid and infringed. Only claim 10 is set out in the opinion which states (p. 937)—

"Claim 10 covers the whole ground by counting on these elements:

"'10. The combination of a motor, controller mechanism therefor, an operator's switch for operating the controller mechanism, a cut-out switch arranged to be opened when the controller mechanism is moved from initial position, a bridging contact for closing the circuit around the cut-out switch, the said contract being arranged to be opened automatically when the circuit is opened, thus taking control from the operator's switch, and means for restoring the controller to initial position and closing the cut-out switch independently of the operator's switch, thus restoring control to the operator's switch, substantially as described.'"

In *Brush Electric Co. v. Fort Wayne Electric Light Co.*, 40 Fed. 826 (1889), the Circuit Court for the District of Indiana, held the claims of the Brush patent No. 219,208 valid and infringed. The claims which defendant urged were invalid on the ground of being functional are as follows:

"(1) In an electric lamp, two or more pairs or sets of carbons, in combination with mechanism constructed to separate said pairs dissimultaneously or successively, substantially as and for the purpose specified.

"(2) In an electric lamp, two or more pairs or sets of carbons, in combination with mechanism constructed to separate said pairs dissimultaneously or successively, and establish the electric light between the members of but one pair, to-wit, the pair last separated, while the members of the remaining pair or pairs are maintained in a separated relation, substantially as shown.

"(3) In an electric lamp having more than one pair or set of carbons, the combination, with said carbon set or pairs, of mechanism constructed to impart to them independent and dissimultaneous separating and

feeding movements, whereby the electric light will be established between the members of but one of said pairs or sets at a time, while the members of the remaining pair or pairs, are maintained in a separate relation, substantially as shown.

"(4) In a single electric lamp, two or more pairs or sets of carbons, all placed in circuit, so that when their members are in contact the current may pass freely though all said pairs alike, in combination with mechanism constructed to separate said pairs dissimultaneously or successively, substantially as and for the purpose shown."

In disposing of this contention of defendants the court said (p. 833):

"It is admitted by the defendants' counsel that the patent in suit describes a new and useful mechanism for which Brush was entitled to a patent; but it is urged that the first, second, third, and fourth claims are for functions or results without regard to mechanism, and are therefore void. The claims are not open to this objection. The specification describes mechanism whereby a result may be accomplished, and the claims are not for mere functions; nor, fairly construed, can it be said that they cover other than equivalent means employed to perform the same functions. The first claim, construed in connection with the means described in the specification, is for an electric arc lamp in which two or more pairs of carbons are used; the adjustable carbons of each pair being independently regulated by one and the same mechanism, and in which there is a dissimultaneous or successive separation of the pairs, so effected as to secure the continuous burning of one pair prior to the establishment of the arc between the other pair. Thus construed, the invention claimed is limited to the particular means described in the specification, and their substantial equivalents. The second, third, and fourth claims also refer to the particular mechanisms described in the specification for the accomplishment of results covered by those claims. They are for combinations of specific mechanisms, and their substantial equivalents, and not for results irrespective of means for their accomplishment."

The same view is taken in *Brush Electric Co. et al. v. Electric Imp. Co.*, 52 Fed. 965 (1892), the Circuit Court for the Northern District of California quoting the above language from *Brush Electric Co. v. Fort Wayne Co., supra*.

These claims were also upheld by the Circuit Court for the Northern District of Ohio in *Brush Electric Co. v. Western Electric Light & Power Co.*, 43 Fed. 533 (1890); in *Brush Electric Co. v. Electric Imp. Co.*, by the Circuit Court for the Northern District of California, 45 Fed. 241 (1891); in *Brush Electric Co. v. Fort Wayne Electric Co.*, by the Circuit Court for the District of Indiana, 44 Fed. 284 (1890), and in *Brush Electric Co. v. New American Electrical Arc Light Co.*, by the Circuit Court for the Southern District of New York, 46 Fed. 79 (1891).

In most of the foregoing cases the attorneys for the defendant have insisted that under the *Wyeth v. Stone* and *O'Reilly v. Morse* cases, the claims before the Master were invalid as for results only or functional, and the Supreme and other courts had occasion to distinguish from these cases, and in doing so held that the respective claims before them were for proper combinations, and their holdings show conclusively that the rules of law applied would make it impossible for this Court to adhere to its decision holding that claim 37 of the Parker patent was invalid because it covered only a function.

One having a knowledge of these decisions and carefully reading claim 37, either taken alone or in connection with the Master's report, could not fairly reach the conclusion that claim 37 claimed only the function or result of an invention, or have assumed it to be invalid on that account, and we think no one prior to the decision of this Court ever suspected that interpretation could be placed upon the report of the Master when taken in connection with claim 37.

We submit that under these authorities plaintiff had no reason to anticipate any holding by this or any other court that the claim was invalid because it claimed only the function or result of an invention, or that it was "*necessary*" to file any disclaimer because of anything said in the Master's report or because of any anticipation that this Court would so hold.

THE OPINION OF THE COURT INDICATES A MISUNDERSTANDING OF THE HISTORY OF THE CASE AND THE FACTS IN RESPECT TO THE FILING OF THE DISCLAIMER OF CLAIM 37 AND OTHER CLAIMS WHICH PLAINTIFF FILED MAY 1, 1931.

The Court in its opinion says:—

“Defendants’ motion was based on the ground that plaintiff’s disclaimer was not seasonably filed according to the provisions of the disclaimer statutes. * * *

Plaintiff asserted an answer thereto, that the disclaimer was timely and sufficient thereunder. It *now urges in addition* that no disclaimer was necessary, because the invalidity of claim 37 was not due to the patentee having claimed ‘more than that of which he was the original or first inventor or discoverer,’ or, in slightly different phraseology, ‘in his specification, claimed to be the original and first discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer,’ but, as the Master found, because the claim failed to describe the invention sufficiently to comply with R. S. Sec. 4888, 38 Stat. 958 (1915), 35 U. S. C. Sec. 33 * * *”,

“The purpose of the Master’s finding as to claim 37 should have been sufficiently apparent to plaintiff upon a reading of that finding alone. Any doubts however should have been dispelled by considering that finding in connection with the finding that claim 29 while ‘more descriptive of function than of the structure’ was saved only by reading it in the light of the specifications, which in effect limits the claim to those elements of the structure, the function of which is described. Such reading could not however aid to save claim 37. Consequently the claim had to stand or fall

on its own wording. It fell because it specified substantially nothing but a function. Invalidity of the claim was not contested by plaintiff after the Master's report. We conclude therefore, not only that the claim 37 was found invalid on grounds which would require reasonable disclaimer, but also that the Master's report, uncontested in this respect, gave plaintiff sufficient notice of the situation."

The facts are that—

December 18, 1929 a "preliminary draft" of the Master's report was submitted to counsel to permit the Master to consider such exceptions and suggestions for amendment as might be offered. (R. 590.) In this report the Master indicated that he proposed recommending that Parker be held to have made a highly meritorious invention, and that claims 3, 22, 29, 40 and 65 asserted were valid and infringed, that claim 41 was valid but not infringed and that claim 37 was invalid because it was not sufficiently definite to comply with Section 4888 of the Revised Statutes.

January 13, 1930 plaintiff responded, filing with the Master certain suggestions in writing (See *Lane Affidavit* and Exhibit A appended thereto filed herewith), and insisted that claim 37 was a proper sub-combination claim, and that its language—

"plainly imports into it *the circuits and circuit closing means* through which 'the starting of the car from each and every landing in either direction,' is caused, and 'the stopping of the car at the respective landings upon its approaching said landings' in the up and down direction, is caused."

Plaintiff also then insisted that—

"It is not necessary that the mechanism covered by a sub-combination claim is operable *per se* for such claim always draws to itself the structure and means, or its equivalent, shown in the drawings and pointed out in the specifications."

In respect to these suggestions the Master in his final report filed February 25, 1930, says (R. 590) :

"The plaintiff excepted to the findings on Claims 37 and 41. No reason has been found to change these findings, although the report has been amended in an effort to further clarify the masters findings on Claim 41.

"The defendants' exceptions, other than those that are formal in character, are directed to the omission of specific findings on certain prior art structures. These omissions were intentional. Those references upon which no findings are made are not considered to be pertinent. If this view is erroneous, it would not assist in correcting the error to include in the report findings made upon what the master considers irrelevant matter. Should there be error, the findings can be made after the error is pointed out and corrected."

The Master concluded among other things:

"5. That Claim 37 is invalid under Section 4888 of the Revised Statutes".

Thus, except as indicated, the Master adhered to the findings of his draft report. Plaintiff filed no further exceptions to this report.

Defendants excepted to the report on numerous grounds raising the question of the validity of claim 37 for almost every other reason available to it than that suggested by the Master. By these it insisted that he erred in failing to find that claim 37 was invalid because—

- (a) anticipated by the patent to Strohn (Exception 61);
- (b) for an aggregation (Exception 76);
- (c) for a different invention than claimed in the original Letters Patent (Exception 111);
- (d) of intervening rights by defendant (Exception 115);
- (e) of unreasonable delay in filing application for reissue (Exception 122); and
- (f) this and other claims of the patent in suit cover merely the function or abstract effect of a machine (Exceptions 30, 31, 32, 33).

Thus defendants clearly indicated that the Master had not held claim 37 invalid because it covered only a function, or

for lack of invention, or because it covered more than that of which the patentee was the original or first inventor or discoverer, but that he regarded it as invalid simply because it was not sufficiently definite to comply with Section 4888 of the Revised Statutes. They also plainly showed without any reservation or condition in respect to the filing of exceptions by plaintiff (contrary to the suggestion of the Court), that defendants' desired a determination that claim 37 was invalid on other more substantial grounds, not merely, a desire to guard against a last minute exception by plaintiff. Furthermore, they recognized that the question of validity of claim 37 under Section 4888 is one of law determinable by the trial Court without exception taken by plaintiff.

Defendants also excepted to the report of the Master on the ground that he erred in not finding that claim 37, and other claims, were

"deliberately and intentionally restricted to separate up and down car buttons and therefore could not be interpreted to include a system embodying only a single set of car buttons for both up and down direction," thus showing that defendants regarded that claim as so limited that it did not cover a system embodying a *single set of car buttons* for both up and down direction.

In other words this is an admission of what we elsewhere contend, *i. e.*, that this claim would not be infringed by

"*any system* controlled by electric switches for accomplishing the same result," as this Court seems to think.

October 15, 1930 the hearing on defendants' exceptions to the Master's report was heard by Judge James and the case taken under advisement.

February 2, 1931 the Supreme Court rendered its decision in *Ensten v. Simon Ascher & Co.*, 282 U. S. 445.

May 1, 1931 (six and one-half months after the hearing before Judge James, and five months before he rendered

his opinion), plaintiff filed a disclaimer of Claim 37 and other claims, stating:

"The sole reason for this disclaimer is that a Special Master, in the case of Otis Elevator Company vs. Pacific Finance Corporation and Llewellyn Iron Work, now pending in and undecided by the District Court of the United States, for the Southern District of California, Central Division, has advised, for reasons likewise applicable to claims 34, 35 and 36, in a report filed by him, that said claim 37 is invalid as not complying with Section 4888 of the Revised Statutes, and as he 'considered that the other claims amply protect the invention.' "

June 17, 1931 defendants filed a motion to dismiss the bill of complaint on the ground that the entire patent was invalid because of unreasonable delay in filing a disclaimer of Claim 37 (R. 622), and five days later filed a brief in support of that motion. In this brief defendants urged in support of their motion, only that the Master had found claim 37 of the Letters Patent in suit invalid, that plaintiff had filed no exception to this finding but had delayed and neglected to file a disclaimer as required by Sections 4917 and 4922 of the Revised Statutes of the United States until May 1, 1931, and that such delay and neglect were unreasonable. They did not urge that the Master had concluded that claim 37 was

"invalid because it claims only the function or result of an invention."

July 20, 1931 plaintiff filed a brief in resistance to defendants' motion to dismiss the bill of complaint (See Exhibit B attached to Lane Affidavit filed herewith) and with it an affidavit of Walter E. F. Bradley, sworn to on July 14, 1931, stating—

"This disclaimer was filed by the plaintiff not because the patentee claimed more than that of which he was the first or original inventor, and not because plaintiff did not believe claim 37 set forth a proper sub-combination. Plaintiff elected as a matter of policy not to retain claim 37 as the invention therein referred to was amply covered by other claims as found by the master in this case, and because the master was

of the opinion it was indefinite and did not comply with Section 4888 R. S."

In its brief before the trial Court in resistance to defendant's motion to dismiss plaintiff presented the following grounds of opposition to the motion:—

(1) That no disclaimer was necessary though proper;

(2) That claim 37 was proper and sufficiently definite as a sub-combination claim to comply with Section 4888 of the Revised Statutes under the authorities applicable;

(3) That notwithstanding this, before any finding of the trial court or the entry of any decree by the trial court, plaintiff had filed a proper if unnecessary disclaimer as to claim 37;

(4) That "The sole reason for filing this disclaimer" was that the Master's report had concluded that "claim 37 is invalid as not complying with Section 4888 of the Revised Statutes," and as he considered that "the other claims amply protect the invention";

(5) That the Master recommended that the claim be held invalid:—

(a) Not because Parker claimed "more than that of which he was the original or first inventor or discoverer";

(b) Not because he claimed "materially more than that of which he was the first to invent";

(c) Not because he claimed to be the first, original inventor or discoverer of a substantial part of a thing of which he was not the original or first discoverer, for the Master definitely found, as shown on the face of his report, "that the other claims amply protect the invention";

but because the Master ruled, as a matter of law, that claim 37 did not comply with Section 4888 of the Revised Statutes as to form, for it did not include "such definition of structure that the elements of structure claimed can be identified."

Thus throughout the proceedings the validity and scope of claim 37 of the Parker patent were constantly in question, at large and before the trial Court for determination.

October 2, 1931 the trial Court filed its opinion setting forth its decision of the cause on the merits and denying

defendants' motion to dismiss the bill of complaint, stating some of the facts, as above related, in respect to the decision in the Ensten case, the filing of the disclaimer and the ground of defendants' motion, and adding (R. 632-3)—

"The argument on the motion to dismiss presented the contention that the plaintiff having failed to except to the finding of invalidity made by the master as to claim 37, and having allowed the time intervening from February 25, 1930, the date of the filing of the master's report, and May 1, 1931, to elapse without disclaiming, the case came within the effect of the decision above cited. That motion was submitted and is now to be first disposed of. It would seem that where no final decree is made adjudging any claim of a patent to be invalid, the patentee is not required to disclaim. It is true that no exception was taken to the report of the master finding claim 37 invalid, but the entire report was, at the time of the making of the motion, still before the court subject to being passed upon, changed or modified. There was no decree interlocutory asked for to confirm the report as to the finding of invalidity for lack of exception taken, hence in my view the matter remained at large and the commencement of the reasonable time within which the plaintiff might disclaim would be the entry of such decree. I am, therefore, of the opinion that the motion to dismiss should be denied, and it is so ordered."

The trial Court did not decide the question of whether or not claim 37 was of such character as to require that it be disclaimed, although defendants' motion also presented that question. Had the trial Court *not* found that the "entire report" of the Master, at the time plaintiff disclaimed, was "still before the Court subject to being passed upon, changed or modified," he would have been required (under defendants' motion to dismiss) to pass upon the question as to what the Master concluded and whether a disclaimer was necessary or not. Under such circumstances plaintiff might have had its day in Court on the question, presented for the first time by this Court's opinion, of whether the claim 37 was functional only and required a disclaimer or an appeal.

Plaintiff insists that in view of the foregoing recital of the facts in respect to the recommendation of the Master as to claim 37, the filing of the disclaimer, defendants' motion to dismiss the bill of complaint and the trial Court's decision denying that motion, it is clear that:—

1. The Master recommended that claim 37 be held invalid as not complying with Section 4888 of the Revised Statutes, for indefiniteness, and not because it claimed any material or substantial part of the thing patented of which the patentee was not the original or first inventor or discoverer.
2. That at no stage of this case prior to the filing of the opinion of this Court, January 23, 1934, did any party, court or other tribunal contend or express the opinion that the Master's report recommended that claim 37 be held to be invalid because it claimed "only the function or result of an invention."
3. That plaintiff has consistently throughout this litigation contended—
 - (a) That claim 37 was a valid claim for a sub-combination of elements of the invention of the Parker patent;
 - (b) That the Master recommended that it be held to be invalid only as not complying with Section 4888 of the Revised Statutes;
 - (c) That the Master's report in respect to claim 37, as well as in all other respects, remained at large until confirmed and effectuated by a decree of the Court appointing him, which should have become final; and
 - (d) That the disclaimer filed by plaintiff on May 1, 1931 was a proper but unnecessary disclaimer.

THIS COURT'S INTERPRETATION OF THE MASTER'S CONCLUSION (R. 590) "THAT CLAIM 37 IS INVALID UNDER SECTION 4888 OF THE REVISED STATUTES" IS MANIFESTLY DIFFERENT FROM THE PLAIN MEANING OF THE WORDS USED BY THE MASTER IN BOTH SUBSTANCE AND EFFECT.

Section 4888 requires that—

"before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor * * * and he shall *particularly point out and distinctly* claim the part, improvement or combination which he claims as his invention or discovery. * * *"

In concluding "that claim 37 is invalid under Section 4888 of the Revised Statutes" the Master unquestionably was of the opinion that the patentee had failed in this instance to

"particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery."

This is in keeping with the statements made by the Master in his discussion of claim 37. After pointing out that—

"this claim mentions the up and down switches both in the car and at the landings, ascribing to them the function of automatically stopping the car"

and observing that they were—

"only a small part of the combination of means which effectuate automatic stopping"

and further observing that certain circuits and circuit closing means which, he thought,—

"must operate to produce the result described in this claim" "are not included in the claim in any way even in general terms, such as the 'means' or 'mechanism' found in the other claims" the Master expressed the "opinion that"

"this description of the result without reference to structure cannot be read on the structure with sufficient accuracy to define the claim."

By way of explanation, he added:

"While the inclusion in a claim of language describing function or result does not render the claim in-

valid, nevertheless, the claim must include such definition of structure that the elements of the structure claimed can be identified."

There can be no doubt that the Master recognized that the claim specified certain means, namely, what he termed "the up and down switches both in the car and at the landings"

for stopping the car. He also recognized the presence in the claim of language—

"ascribing to them [those switches] the function of automatically stopping the car."

It can only be assumed that if he had mentioned the "switching mechanism within the car"

he would likewise have ascribed to it

"the function of * * * starting the car."

It seems clear that what the Master meant by the expression

"this description of the result without reference to structure,"

which he was unable to read—

"on the structure with sufficient accuracy to define the claim"

were the clause

"both the up switches within the car and the up switches without the car *being operable to cause the stopping* of the car at the respective landings upon its approaching said landings in the up direction,"

and the clause—

"both the down switches within the car and the down switches without the car being operable to cause the stopping of the car at the respective landings upon its approaching said landings in the down direction,"

respectively, limiting and defining those switches and, although the Master failed to realize it, importing into the claim,

"the circuits and circuit closing means"

described in the specification, under accepted rules of patent construction.

The phrase "operable to cause," if it is to be given any real effect—and it would not have been inserted in the claim if it were not intended to have significance—connotes such means and mechanism described in the specification as might be essential to the accomplishment of the result stated,* namely,

"the stopping of the car at the respective landings upon its approaching said landings."

In recognizing that

"While the inclusion in a claim of language describing function or result does not render the claim invalid"

the Master, plainly indicated that, unlike the Court, he did not regard those clauses as extending the scope of claim 37 to cover

"any system controlled by electric switches for accomplishing the same result"

or as rendering the claim one for a function only, but—overlooking their real significance—that he considered those clauses to be insufficient to cover what he deemed requisite additional elements or means, namely,

"the circuits and circuit closing means",
to produce the result described in this claim.

This interpretation of the Master's report in respect to claim 37 is wholly consistent with the language and purpose of Section 4888 of the Revised Statutes. It means that, in the opinion of the Master, the patentee failed to "stake out the boundaries" of his invention in this claim. The situation is analogous to that where the grantor of a supposedly rectangular tract of land in his deed omitted one side of the rectangle from his description. The effect

* "A claim may declare that it covers so much of the desired mechanism as effects a particular specified result, without specifying those parts themselves."

Walker on Patents, Sixth Edition, Section 219, page 295.

Silsby v. Foote, 14 How. 218, 225.

Hoe v. Knap, 27 Fed. 204.

of the claim and the effect of the deed alike are a nullity, for neither describes anything definite. It is an entirely different situation from that of a patentee who—

“has claimed more than that of which he was the first or original inventor or discoverer.”

Such a patentee is rather in the position of a grantee whose deed adequately describes a tract of land one acre in extent and who predicates upon it a claim to a tract two acres in extent.

The interpretation placed by the Court on the Master's report in respect to claim 37 invokes an entirely different statutory provision, namely, Section 4886 of the Revised Statutes. It is this section which defines patentable subject matter as—

“any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof.”

And it is because the courts have held that an *idea or a function or result only* is not included within the limitations of Section 4886 that a patent or a claim therefor is invalid. Relating, as it does, to “a control system for an elevator car” claim 37 is clearly embraced by the language quoted and patentable subject matter. No language of this provision pertains to the form or definiteness of the patent or claim.

THE COURT CLEARLY MISINTERPRETS AND MISAPPLIES THE DISCLAIMER STATUTES AND THE DECISIONS OF THE SUPREME AND OTHER FEDERAL COURTS PERTAINING THERETO AND SUBSTITUTES A RULE OF DOUBT FOR THAT OF CONVICTION OF AWARENESS BASED UPON ADJUDICATION LAID DOWN IN THE ENSTEN CASE FOR TOLLING THE LIMITATION UPON THE FILING OF THE DISCLAIMER.

The language of the disclaimer statutes quoted in the opinion makes it clear that the filing of a disclaimer is required only when any material or substantial part of the

thing patented was not the invention or discovery of the patentee. When such is the case the requirement is that the disclaimer be filed without unreasonable neglect or delay. The provisions of the statutes were obviously intended to relieve a patentee from forfeiture of all rights under his patent consequent upon having included in it more than that of which he was the inventor or discoverer and in *Ensten v. Simon Ascher & Co.*, 282 U. S. 445, 455, were characterized as benign. Under accepted rules of statutory construction they should be fairly interpreted with a view to the end sought, namely, the protection of a patentee in his actual invention. As the court said in the *Ensten* case (282 U. S. 445, 452) :

“The statute is remedial; the intent is to aid the inventor free from wilful default or intention to mislead the public by permitting him to avoid the consequence of inadvertence, accident or mistake through prompt disavowal of the apparent right to exclude others from something improperly included in the words of his grant.”

The question is :

What tolls the limitation of “unreasonable neglect or delay in filing” a disclaimer? In other words, when must a disclaimer be filed? In the *Ensten* case it was a final decree of a District Court of the United States adjudging the claim to be invalid in view of the prior art, *i. e.*, as too broad or including more than that of which “the patentee was the original or first inventor or discoverer,” and the disclaimer was not filed until more than twenty-three months after the entry of the decree. In holding that the patentee in that case had “been guilty of unreasonable delay and” had “not brought himself within the beneficent provisions of the statute” the court adopted the classical statement of Robinson on Patents (1890) Vol. II, p. 284, as follows (p. 452) :

“‘The same principle which forbids a patentee to as-

sert a right to more than he has actually invented compels him to disavow the right as soon as he discovers that it has been unjustly claimed. Unreasonable delay in disclaiming is thus tantamount to an original fraudulent claim, and through it the patentee loses the privilege of making the amendment by which alone his patent could be saved. The question of unreasonable delay is a question for the court, upon the facts as found either by its own investigation or the verdict of a jury. Delay begins whenever the patentee *becomes aware* that he has claimed more than he has invented or described. In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the *allowance of his claim by the patent office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention.*"

The principle of that decision clearly is that the limitation of the statutes upon

"unreasonable neglect or delay in filing"
a disclaimer begins to run when and only when a patentee
"*becomes aware*"

that he was not

"the original or first inventor or discoverer" of "a material or substantial part of the thing patented"
as a result of a decision of

"a court of competent jurisdiction."

Overlooking the real significance of the principle thus stated and adopted by the Supreme Court this Court misinterpreted it and quoting another portion of the opinion with reference to it in substance erroneously says of the decision in the Ensten case that it—

"Indicates that the determinative factor is not the finality of the decision, but the knowledge brought home to the patentee by the determination of a competent tribunal that he is the holder of a doubtful claim."

Thus in effect this Court would substitute for *awareness* by the patentee *impressed with certainty* by a final adjudic-

cation of a competent court or other tribunal, that he was not

"the original or first inventor or discoverer" of "a material or substantial part of the thing patented" as tolling that limitation, uncertainty impressed by a determination, at most interlocutory, that the claim is "doubtful," although the courts generally that all doubts are to be resolved in favor of the patentee—

Consolidated Contract Co. v. Hassam Paving Co.,
227 Fed. 436 (C. C. A. 9).

Schumacher et al. v. Buttonlath Mfg. Co., 292 Fed.
522 (C. C. A. 9).

J. A. Mohr & Son v. Alliance Securities Co., 14 F.
(2d) 799 (C. C. A. 9).

Donner v. Sheer Pharmacal Corp., 64 F. (2d) 217,
(C. C. A. 8).

In other words, notwithstanding that no one previous to the decision of this Court has intimated that the language of the Master indicated that claim 37 was invalid because functional only, and the language itself certainly does not make any such assumption clear, this Court would strike down the Parker patent by imputing to plaintiff a cognizance which it never had,* and which apparently, if present even by inference, was first discovered by the erudition of this Court; that is, this Court finds awareness where, at the best, only doubt existed.

This misinterpretation of the disclaimer statutes and the decisions of the Supreme Court in the Ensten case and misapplication thereof to the facts here is further reflected in the court's reference to a quotation from *Radio Condenser Co. v. General Instrument Corp.* (C. C. A. 2), 65 F. (2d) 458, which, it is stated, has carried the interpretation of the Ensten case even further than this Court does in the opinion under consideration.

*See also Lane affidavit filed herewith.

The opinion in *Radio Condenser Co. v. General Instruments Corp.* plainly indicates that the court intended to go no further in that case than the Supreme Court went in the Ensten case, for it is stated (65 F. (2d) 458, 459) that—

“Delay begins whenever the patentee *becomes aware* that he has claimed more than he has invented or described.”

The authority for that statement is none other than “Robinson on Patents (1890) Vol. II, p. 284,” quoted with approval in *Ensten v. Simon, Ascher & Co.*, 282 U. S. 445, 453.

To be sure, the determination which that court regarded as starting the limitation upon the filing of a disclaimer was not the final decree of a federal court but it was, in effect, the final decision of the authority which granted the patent and consequently had the effect unquestionably of withdrawing from the patent the presumption of validity which otherwise would have attended it.

The decision in *Radio Condenser Co. v. General Instrument Corp.* (C. C. A. 2), 65 F. (2d) 458, manifestly does not apply here because—

- (1) The court was there dealing with a situation where the patentee claimed to be the inventor of something he was not;
- (2) The decision of the Examiner of Interferences on the question of who was the first inventor was in effect the decision of the authority which granted the patent and became final unless an appeal was promptly taken under Section 4904 of the Revised Statutes;
- (3) There was no appeal taken from the decision of the Examiner of Interferences in that case; and the time for appeal had long expired;
- (4) A counterclaim in that case was not filed until four years after the Examiner’s decision became final; and

(5) In that case no disclaimer was filed at any time; whereas in the instant case there had been no final adjudication that claim 37 was invalid; the Master's recommendation that claim 37 was invalid simply because it was not sufficiently definite to comply with Section 4888 of the Revised Statutes and was still at large when the proper though unnecessary disclaimer was filed as distinguished from the requisite conviction by adjudication of its invalidity, as held in the Bassick case. Such a holding is not the *awareness* that the patentee claimed more than that of which he was the original or first inventor required even in the Radio Condenser case; and the disclaimer though proper was not necessary for the basis of the suggestion of invalidity (the Master's recommendation) was merely because it failed to describe a complete, operable mechanism and, therefore, was indefinite under Section 4888 of the Revised Statutes.

Unfortunately this Court failed to appreciate the full effect of an earlier decision of the same court in *Bassick Mfg. Co. v. Adams Grease Gun Corp.*, (C. C. A. 2) 52 F. (2d) 36, cited without comment, upon much more closely analogous facts and fully justifying plaintiff's position here. In the Bassick case the *court* not the master had actually held the claim there in question invalid and the decision had become final as to it but remained subject to review as to other claims of the patent until sixteen days before the disclaimer was filed. In disposing of defendant's motion to dismiss because of alleged delay in filing a disclaimer the court, speaking through Circuit Judge Swan, said (p. 39):

"It is contended that plaintiff cannot maintain its suit upon any of the claims of the Gullborg patent in suit because of delay in filing a disclaimer as to claim 12. This claim was held invalid in the litigation re-

ported as *Lyman Mfg. Co. v. Bassick Mfg. Co.*, 18 F. (2d) 29 (C. C. A. 6). That litigation included six suits, all of which were disposed of in a single opinion on March 23, 1927. Petitions for rehearing were filed in two of the suits, neither of which, however, involved claim 12. These petitions for rehearing having been denied May 13th, the plaintiff contends that the time for presenting a petition for certiorari did not expire until August 13th, and that its disclaimer filed on August 29th was well within the period which this court sanctioned as a reasonable time within which to disclaim, in *R. Hoe & Co. v. Goss Printing Press Co.* (C. C. A.) 31 F. (2d) 565, and *Ensten v. Simon, Ascher & Co.*, (C. C. A.) 38 F. (2d) 71, affirmed, 282 U. S. 445, 51 S. Ct. 207, 75 L. Ed. 453. The defendant, on the other hand, contends that in each of the suits involving claim 12 the mandate was filed April 23rd, so that the time to apply for a writ of certiorari expired July 23rd and the time to disclaim thirty days thereafter. The question is of seasonable action. Ordinarily, thirty days after the time expires to petition for certiorari would seem to give the patentee reasonable opportunity to determine his course of action, as we said in the Hoe and Ensten Cases. In the case at bar, however, the decision that claim 12 was invalid was announced in an opinion which was subject to review as to other claims until August 13th. We do not think the companion suits can be ignored merely because they did not involve claim 12. Had the writ of certiorari been allowed, the Supreme Court's decision as to the other claims might have resulted in such a construction of them as would have cast doubt upon the correctness of the lower court's disposition of claim 12. It was not an unreasonable delay for the patent owner to await this possibility before determining to file the disclaimer."

It will be noted that in that case no attempt was made to secure a rehearing or writ of certiorari with respect to claim 12, held invalid. Review was sought only as to the other claims. The court held that it was not unreasonable for the patent owner to *await the possibility* of a Supreme Court holding as to the other claims which might have re-

sulted in such a construction of them as would have cast doubt upon the lower court's disposition of claim 12.

Certainly under this authority there was no unreasonable delay in filing the disclaimer in the instant case, assuming (contrary to the fact) one was necessary, for at any time before filing its disclaimer the plaintiff could have argued the question of law as to whether or not claim 37 was invalid as not complying with Section 4888, irrespective of whether or not exception had been taken when he disclaimed if he had elected so to do.

We respectfully refer the Court to a further discussion of points and authorities cited in plaintiff's main brief on this appeal, pp. 168-185, inclusive, and in its reply brief, pp. 63-74, inclusive, particularly *Carson v. American Smelting Co.* (C. C. A. 9), 4 F. (2) 463, and *Sachs v. Hartford Electric Supply Co.* (C. C. A. 2), 47 F. (2) 743.

In the last paragraph of its opinion the court recognizes the confusion in the decisions of the Supreme Court and in the various circuits prior to the decision in the Ensten case on February 2, 1931, and at the time of the filing of the Master's report in this case on or about February 25, 1930, in respect to disclaimer requirements. Notwithstanding this:

(a) notwithstanding the admittedly tentative character of the Master's report and the reservation to the court of the determination of questions of law arising therefrom (including the interpretation of a patent claim), especially in view of the unfortunate situation prevailing in the federal courts of California in respect to references to Masters in patent cases;

(b) notwithstanding the Master's recommendations in respect to claim 37 that it was invalid only because insufficient under Revised Statutes, Sec. 4888 (which this Court, says, taken in connection with even a casual reading of the claim, found it covered a function only;

(c) despite the fact that this question has not been argued and whereas both plaintiff and defendants

had consistently considered that the Master regarded it as indefinite);

(d) notwithstanding neither defendants nor the public have been prejudiced by plaintiff's filing a disclaimer of claim 37 or taking no exception to the Master's final report in respect to that claim; and

(e) notwithstanding uncertainty in the decisions of the courts in respect to the filing of a proper as distinguished from a necessary disclaimer and whether in view of the susceptibility of the recommendation of the Master to conflicting interpretations, as the opinion of this court shows, a disclaimer of claim 37 would be either proper or necessary;

this Court, in one and the same opinion, overlooking the remedial character of the disclaimer statutes as noted in the Ensten case and, we submit, departing from fundamental principles of equity, has for the first time adjudicated both the invalidity of the claim and the limitation upon the filing of a disclaimer thereof, thus in effect retroactively imposing a duty and simultaneously determining a default in the performance thereof and with one blow destroyed a patent for what the Master held to be an important invention (R. 574), and which the trial Court has sustained.

**THE COURT INDICATES—ERRONEOUSLY WE SUBMIT—that
THE FILING OF A DISCLAIMER BY PLAINTIFF ON MAY 1,
1931, IS AN ADMISSION BY PLAINTIFF THAT IT WAS UNDER
THE NECESSITY OF SO DOING.**

Such an inference is not only harsh in view of the quandary in which any patent owner must have found himself under the circumstances, especially where (as the Master considered, R. 570)—

“the other claims amply protect the invention,” but, we feel, unwarranted in view of the confusion in the decisions of the courts interpreting the disclaimer statutes before and since the date when the disclaimer was filed.

Plaintiff's act in filing the disclaimer was clearly voluntary and subject to no adverse inference. As Judge Learned Hand said in *Sachs v. Hartford*, 47 F. (2d) 743,

747, in respect to a patentee's right voluntarily to file a disclaimer,

"There is no objection to his limiting a valid patent as his fears may dictate."

As Judge Denison, speaking for the Court of Appeals of the Sixth Circuit, in *Permutit Co. v. Wadham*, 13 F. (2d) 454, 457, said:

"We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. The patentee decides a question of policy; he may think that, although the supposed anticipation can be successfully met and defeated, a disclaimer will not affect the real value of his patent, and to make it will save trouble and expense and do no harm. We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect of the other matter; and it has been so held. *Manhattan Co. v. Helios Co.*, 135 F. 785, 802."

See also:

Manhattan General Const. Co. v. Helois-Upton Co.,
135 Fed. 785, 802 (C. C. Pa.);

Walker on Patents, Sixth Ed. p. 342, Sec. 258;

Bay State Optical Co. v. Klein, 20 F. (2d) 915, 917.

CONCLUSION.

For the reasons stated in the petition for rehearing and this brief, we feel that the Court should grant the prayer of the petition, and either give plaintiff an opportunity to present the questions here involved by oral argument, or in the alternative, reverse or reform its opinion to comply with the prayer of the petition.

Respectfully submitted,

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